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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 802

THE BLACK AND DECKER MANUFACTURING COMPANY,
Petitioner,

vs.

THE PORTER-CABLE MACHINE COMPANY AND ROCKWELL MANUFACTURING COMPANY,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND APPENDIX

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INDEX

	PAGE
Opinions Below	1
Jurisdiction	1
The Questions Presented	2
Constitutional and Statutory Provisions	3
The Constitution, Art. 1, Sec. 8	3
35 U. S. C. Chapter 10—Patentability of Inventions	3
§ 100. Definitions	3
§ 101. Inventions patentable	3
§ 103. Conditions for patentability; non-obvious subject matter	3
Statement of the Case	4
In the District Court	4
In the Court of Appeals	5
Federal Jurisdiction of Courts Below	6
ARGUMENT	6
Question I	6
The Urgency of Need for an Answer by This Court to Question I	6
On the Merits as to Question I	7
Question II	13
Question III	14

PAGE

Conclusion 17

Appendix 1a

Opinion of the United States Court of Appeals for the Fourth Circuit, Filed September 13, 1968 ..... 1a

Judgment, Entered September 13, 1968 ..... 7a

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967 ..... 8a

Interlocutory Judgment, Entered November 3, 1967 ..... 41a

Opinion from the Fifth Circuit (*Swofford et al.* v. *B & W, Inc.*) 44a

LIST OF AUTHORITIES

AMP v. *Burndy*, (3 Cir. 1964) 322 F. 2d 236 16

Calmar, Inc. v. *Cook Chemical Co.*, 383 U. S. 1 (1966) 11

Colgate-Palmolive Co. v. *Cook Chemical Co.*, 383 U. S. 1 (1966) 11

General Instrument v. *Hughes Aircraft*, 399 F. 2d 373 (1 Cir. July 18, 1968) 7

Graham v. *John Deere*, 383 U. S. 1 (1966) 2, 4, 5, 7, 11, 12, 14, 15, 16

Graver Tank & Mfg. Co. v. *Linde Air Products Co.*, 336 U. S. 271 (1949) 9, 14

Great Atlantic & Pacific Tea Co. v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950) 9–10

Hotchkiss v. *Greenwood*, 11 How. 248 (1850) 11

Keiser v. *McLouth*,....F. 2d...., 158 U. S. P. Q. 565 (6 Cir. August 1968) 7

PAGE

Koppers v. *Foster-Grant*, 396 F. 2d 370 (1 Cir. June 6, 1968) 7

Mercoid v. *Mid-Continent*, 320 U. S. 661 (1944) 8

Precision Co. v. *Automotive Co.*, 324 U. S. 806 (1945) 8

Swofford et al. v. *B & W, Inc.*,....F. 2d...., 158 U. S. P. Q. 72 (May 22, 1968) 6, 7

United States v. *Adams*, 383 U. S. 39 (1966) 12

OTHER AUTHORITIES

The Constitution, Art. 1, Sec. 8 3

F. R. Civ. P. Rule 52(a) 9, 13

28 U. S. C. § 1254(1) 2

§ 1338 6

§ 1400 6

35 U. S. C. Chap. 10—Patentability of Inventions ... 3

§ 100—Definitions 3

§ 101—Inventions Patentable 3

§ 103—Conditions for patentability; non-obvious subject matter 3, 10, 12, 13

§ 112 14

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Petitioner prays that a Writ of Certiorari issue to review the decision in this cause of the United States Court of Appeals for the Fourth Circuit.

Opinions Below

A copy of the opinion of the Court of Appeals, sought to be reviewed, together with the dissent, is in the appendix of this petition, pp. 1a-6a. It is reported at F. 2d , 159 U.S.P.Q. 65. A copy of the opinion of the District Court, affirmed by the Court of Appeals, is in the appendix, pp. 8a-43a. It is reported at 274 F. Supp. 905 (D. Md. 1967).

Jurisdiction

The opinion and judgment of the Court of Appeals were entered September 13, 1968. Petition for Rehearing was denied October 28, 1968.

Jurisdiction of writ of certiorari is invoked under 28 U.S.C. 1254(1).

The Questions Presented

I. Can a patent lawfully be adjudged valid by a United States Court of Appeals on the sole basis of fact findings of novelty, utility and obviousness by the court below, in the absence of further judicial determination by the Court of Appeals that the subject matter claimed satisfies the constitutional requirement of invention?

The decision below, holding that obviousness is a matter of fact whose determination controls the issue of patent validity, is in direct conflict with the decisions of other circuits, notably that of the Fifth Circuit (see p. 6 below), holding that obviousness is a *question of law*. This conflict stems from misunderstanding of this Court's opinion in *Graham* v. *John Deere*, 383 U. S. 1, 24-6, 30-7 (1966). The misunderstanding has led to widespread differences as to this controlling rule of decision in patent cases, and resolution of the conflict by this Court is called for by dictates of sound public policy.

II. In determining patentable invention, can obviousness lawfully be judged by comparing the prior art with the device disclosed, and not with the specific combinations of elements actually claimed in the patent?

The Court of Appeals affirmed the lower court's finding of non-obviousness despite the fact that it was based on a comparison of the prior art with the device disclosed in the patent, not with the subject matter *claimed*.

III. Can the claims of the patent in suit be lawfully or properly construed without reference to the cancellation and abandonment of the original claims, where the prosecution history shows that the patented claims were granted pursuant to an amendment inserting a limitation in the original claims, theretofore rejected as unpatentable over the prior art, the limitation being represented to the Patent Office Examiner with "particular emphasis" as "very important" and here characterized by the patentee as neither "a critical distinction or any distinction"?

The District Court disregarded the proceedings in the Patent Office in determining invention. The majority below disregarded the prosecution history as well as the claims and the prior art. The dissenting opinion (App. 5a-6a) properly construed all three in determining that the subject matter actually claimed was obvious and the claims invalid.

Constitutional and Statutory Provisions

The Constitution

"ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

35 U. S. C. Chapter 10—Patentability of Inventions

"§ 100. *Definitions*

When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

* * *

"§ 101. *Inventions patentable*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

* * *

"§ 103. *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Statement of the Case

In the District Court

The District Judge held the claims of the patent in suit valid in an opinion (App. 8a-40a) stated to embody his findings of fact and conclusions of law (App. 40a).

In form that opinion followed the precepts laid down by this Court in *Graham* v. *John Deere,* 383 U.S. 1, 17 (1966) (See App. 26a). In fact it ignored the fundamental precept that "the differences between the prior art and the *claims at issue* are to be ascertained" (*Graham,* pp. 17, 18, emphasis added).

In the section entitled "The Patent in Suit", the opinion quotes the claims relied on (App. 9a-11a). But from there on it ignores them. In the section entitled "Prior Art" (App. 16a-22a), the opinion uses, not the claims, but *the device disclosed* in the patent as the sole basis of comparison with the individual items of the prior art.

It is startling but true that the district court's characterization of "the invention here involved" contains *none* of the features recited in *any* of the claims in suit.* The

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* (App. 18a) "It should be noted for a *full understanding of the nature of the invention here involved* that the patent in suit discloses a hand-manipulated power saw with the blade operating with orbital motion which cuts on the upstroke, resulting in a splintering problem on the upper side of the work surface.[5]" (Emphasis ours)

Footnote 5 (App. 18a) states:

> "The defendant argues that neither the patent not the specifications mention or describe orbital motion. However, it is clear from the specifications that the invention relates to a reciprocating type saw blade which cuts on the upstroke with resultant chipping on the top surface of the work. Furthermore, the specifications incorporate by reference an earlier Bruck patent, No. 2,737,987, which does describe orbital motion in some detail."

In fact the claims in suit do not mention "orbital motion", cutting on "the upstroke" or "splintering" or "chipping". Defendant's saw blades admittedly do not have "orbital motion."

central feature of the judge's description of the invention was the "orbital motion" of the saw blade which had been previously and separately patented, and which is not claimed in the patent in suit.

In the section on "Obviousness" (App. 26a-29a), the opinion disposes of the prior art on the basis of its earlier comparison, referring again to the unclaimed "orbital motion" of the saw as the "frame of reference" (App. 26a, bottom of the page).

Nowhere does the district court opinion attempt to ascertain the "differences between the prior art and the claims at issue" (as prescribed in *Graham* at p. 17). Nowhere does the opinion refer to the Patent Office proceedings to determine the subject matter actually claimed, as this Court did in *Graham* (at pp. 22-3 and pp. 31-4). The sole reference in the opinion to those proceedings is in the section on "Indefiniteness" (App. 31a-33a) to which it is irrelevant.

In the Court of Appeals

The majority of the three judge panel, one judge dissenting, accepted the findings below as dispositive and justifying affirmance without more. The opinion says (App. 3a-4a, and 5a):

> "Determination of this controversy called for resolution of the issues of prior art, anticipation, utility, obviousness, and infringement. Confessedly, they present close questions. . . . These controlling inquiries are factual. . . ." (Citing *Graham* at p. 17).
>
> * * *
>
> "Literally, therefore, decisions upon these issues come within the commandment of Rule 52 F.R. Civ. P., that we honor them unless clearly in error."
>
> * * *
>
> "From these foundation facts, patentability of the *device* in suit soundly follows as a conclusion of law . . . Affirmed". (Emphasis added)

The dissenting opinion (App. 5a-6a) refers to the proceedings in the Patent Office to ascertain the limited subject matter actually claimed and concludes that "the *claims* in the patent are obvious to one skilled in the art" (Emphasis added).

The petition for rehearing concentrated on the error of the majority opinion in affirming an adjudication of patent validity based on fact-findings alone and without judicial determination that the subject matter claimed satisfies the constitutional requirement of invention. The petition was denied without opinion.

Federal Jurisdiction of Courts Below

This is a suit for patent infringement. Jurisdiction of federal courts is founded on 28 U. S. C. §§ 1338 and 1400.

ARGUMENT

Question I

The Urgency of Need for an Answer by This Court to Question I

Question I is today a major and constantly recurring basis of conflict and diversity of decision between the courts of appeals in patent cases. The conflict is strikingly presented in the opinion in the Fifth Circuit case, *Swofford* v. *B. & W, Inc.,* F. 2d , 158 U. S. P. Q. 72 (May 22, 1968),* Petition for Certiorari (No. 442 dated August 26, 1968) denied November 12, 1968.** The Fifth Circuit held, exactly contrary to the holding in the Fourth Circuit case at bar, that obviousness is a "*question of law*" to be decided by the court, notwithstanding a jury verdict of non-obviousness. The Fifth Circuit opinion marshals

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* A copy of that decision is in the Appendix (pp. 44a-55a) for convenient reference to its array of conflicting decisions.

** We are informed that a petition for rehearing of that petition has been or is about to be filed.

the recent decisions for and against its conclusion and reports the majority as in accord with its view.

Since *Swofford, supra,* at least two other circuit courts of appeals have handed down opinions that reveal the same conflict.*

The conflict on this issue between so many courts of appeals presents a question of high policy which should be, but has not been, clearly settled by this Court, and which, unresolved, has led and will continue to lead to differences in the administration of the patent laws in different circuits which are contrary to the public interest.

On the Merits as to Question I

The Fourth Circuit, in the decision sought to be reviewed, interpreted *Graham* as prescribing that obviousness is a question of fact. The Fifth Circuit, in *Swofford,* interpreted *Graham* as holding, consistently with *A & P* v. *Supermarket,* 340 U. S. 147 (1950), that obviousness is a question of law. These cases are but recent examples of a series of recent conflicting decisions in the Courts of Appeals, as shown by the earlier decisions cited in *Swofford* (See App. 47a-54a).

The broad issue that cries out for decision by this Court is this: *Is obviousness a question of fact or a question of law?*

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* *Koppers* v. *Foster-Grant,* 396 F. 2d 370, 372 (1 Cir. June 6, 1968)—

> "In this situation, although, within limits, a question of law, the determination whether a discovery of a new combination is or is not obvious must be a question of fact.";

General Instrument v. *Hughes Aircraft,* 399 F. 2d 373 (1 Cir. July 18, 1968—same statement quoted at p. 384; *Keiser* v. *McLouth,* —— F. 2d , 158 U. S. P. Q. 565, 571 (6 Cir. August 1968)—

> "The ultimate question is one of law because it amounts to a determination of obviousness or nonobviousness."

More accurately, we submit, the issue is whether a fact finding of non-obviousness, plus novelty and utility, is sufficient to satisfy the constitutional requirement of invention. Are there only these three *factual* conditions which, being met, the patentability of the invention is automatically established? Or is there a fourth condition, namely that "the differences between the prior art and the claims at issue" must not only be non-obvious to the fact finder but also non-obvious to the court, as such, because, as a matter of law, they meet a legal "standard of invention" based on the Constitution?

Implicit in the cases holding that obviousness is a question of law is recognition of this fourth condition as an essential ingredient in the test of obviousness under § 103. Obviousness in point of law, in the sense of insufficiency to meet the legal standard, is, in their view, an overriding consideration for judicial determination in the light of all the facts. This, we submit, is the view that must be taken if patents are to be kept within constitutional limitations.

Implicit in the cases holding that obviousness is a question of fact is a rejection of the theory that the Constitution imposes any judicial restraint on adjudications as to patentable invention based on fact findings alone.

There are temptations in this latter view. The troublesome question of invention, *vel non*, could be left entirely to the jury. Only the fact finder need be concerned with it. The Court of Appeals, and this Court, would be relieved of all duty of review beyond that of determining whether the findings were "clearly erroneous" in point of fact.

But "it is the public interest which is dominant in the patent system," *Mercoid* v. *Mid-Continent*, 320 U. S. 661, 665 (1944). "The possession and assertion of patent rights are 'issues of great moment to the public.' " *Precision Co.* v. *Automotive Co.*, 324 U. S. 806, 815 (1945).

Should the basic question of constitutional sufficiency rest on fact findings alone, without judicial review?

The last three patent cases decided in this Court demonstrate the need for a clear ruling on this question.

In the earliest of the three, *Graver* v. *Linde,* 336 U. S. 271 (1949), the findings below, bolstered by the "two court rule" and F. R. Civ. P. Rule 52(a), were held sufficient to justify affirmance of the validity of the four specific "flux claims", which the district judge had found patentable. Mr. Justice Black filed a concurring opinion, in which Mr. Justice Douglas joined, stating at pages 280-1:

> ". . . I would adhere to this Court's earlier pronouncement that 'whether the thing patented amounts to a patentable invention' is a question of law to be decided by the courts as such. *Mahn* v. *Harwood,* 112 U. S. 354, 358; and see dissenting opinions in *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.,* 321 U. S. 275, 280, note 1, and *Williams Manufacturing Co.* v. *United Shoe Machinery Corp.,* 316 U. S. 364, 383.
>
> "I agree, however, that the facts found here justify the holding that Claims 18, 20, 22, and 23 do show patentable discovery when measured by the standards announced by this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.,* 314 U. S. 84."

In the second case, *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.,* 340 U. S. 147 (1950), this Court reversed the decision of the Court of Appeals which had affirmed "the finding of invention as one of fact" by the district court.

This Court stated at p. 152 that:

> ". . . Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics."

* * *

> ". . . Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

It concluded, at pp. 153-4:

> ". . . We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components."

In their concurring opinion Justices Douglas and Black stated, at pp. 155-6:

> "The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law. *Mahn* v. *Harwood*, 112 U. S. 354, 358. The Court fashioned in *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275, a rule for patent cases to the effect that this Court will not disturb a finding of invention made by two lower courts, in absence of a very obvious and exceptional showing of error. That rule, imported from other fields, never had a place in patent law. Having served its purpose in *Graver Mfg. Co.* v. *Linde Co.*, it is now in substance rejected. The Court now recognizes what has long been apparent in our cases: that it is the 'standard of invention' that controls. That is present in every case where the validity of a patent is in issue. It is that question which the Court must decide. No 'finding of fact' can be a substitute for it in any case. The question of invention goes back to the constitutional standard in every case. We speak with final authority on that constitutional issue as we do on many others."

Enactment of the Patent Act of 1952 followed, with its new § 103, which, some have suggested, may have been a Congressional reaction to the statement in the concurring opinion just quoted.

The third case, *Graham* v. *Deere,* 383 U. S. 1 (treating as one the four cases concurrently decided (1966) *Graham* v. *Deere,* pp. 1-26, *Calmar* v. *Cook* and *Colgate* v. *Cook* at pp. 26-37, and *United States* v. *Adams* at pp. 39-52), contains the only pronouncements by this Court on the subject since the 1952 enactment. There § 103 was the central issue. The Court found it a constitutional restatement of the "Hotchkiss test" of invention laid down in *Hotchkiss* v. *Greenwood,* 11 Howard 248 (1850). But the opinion includes qualifications which have cast doubt on the question presented here and which have promoted the sharp conflict of decision noted above.

What is most significant about the *Graham* decisions—indeed the decisive factor in each case—is that this Court *did not hold itself bound* by the findings or conclusions of the courts below as to non-obviousness or patentable invention; it proceeded independently to evaluate the claims in each case by reference to the proceedings in the Patent Office and the prior art and reached its own judicial determination of the issue of obviousness as *matter of law.*

Thus, in *Graham,* this Court rejected the legal theory on which the court of appeals had held the patent invalid (at p. 4) but affirmed its judgment on the ground that the patent was invalid under § 103 because the differences between the claims and the prior art were obvious (at p. 24).

In *Cook,* despite the district court's finding that the subject matter of the patent was new, useful and non-obvious (see 383 U. S. at p. 30), affirmed by the court of appeals, this Court again scrutinized the claims in the light of the Patent Office proceedings and the prior art and concluded, at pp. 36-7 that:

> "To *us,* the limited claims of the Scoggin patent are clearly evident from the prior art as it stood at the time of the invention.
>
> "*We* conclude that the claims must fall as not meeting the test of § 103, since the differences between them and the pertinent prior art would have been obvious to a person reasonably skilled in that art." (Emphasis ours)

And in *Adams,* the Court affirmed the decision of the Court of Claims adjudging the patent valid, not on the basis of the finding of non-obviousness below but on its own thorough examination of the prior art and conclusion that the Adams battery was non-obvious (at 383 U. S. 51-2).

If obviousness were a question of fact, as held in the court below, all of this Court's painstaking analyses of the patents, the Patent Office prosecution histories and the prior art in these cases would have been unnecessary and improper, except to determine whether there had been clear error in the fact finding below. The outcome would have been the same in *Graham* and *Adams.* But the outcome in *Cook* would necessarily have been affirmance instead of reversal.

In all these cases, this Court treated the question of obviousness, under § 103, as a question of law to be decided on the basis of its own independent inquiry and judicial determination. But this message has not reached all of the lower courts, as the present case amply demonstrates.

Unless this Court is to repudiate its decision in *Graham* and its companion cases, the answer to Question I must be, we submit, that the district court's finding of non-obviousness over the prior art is a conclusion of law which an appellate court is in duty bound to review.

If "obviousness" as used in § 103 is equated to the "Hotchkiss test" and the older term "invention" (383 U. S. at p. 17), the opinion in *Graham* nevertheless makes it explicit, both by example and by words, that the new section does not alter the "general level of innovation necessary to sustain patentability" (at p. 4). The 1952 revision of the statute, adding non-obviousness as a prerequisite to patentability, "was not intended by Congress to change the general level of patentable invention" (at p. 17) nor to relax the standard applied by the Court in its decisions over the years. "The standard has remained invariable in this Court" (at p. 19). "The emphasis [of

the new section 103] on non-obviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures" (at p. 17).

If these statements do not categorically answer the question whether "the determination of obviousness or non-obviousness of the subject matter claimed" (see p. 17) is one of fact or one of law, they plainly establish that there is a standard of invention, a constitutional standard, a general and invariable level of innovation necessary to sustain patentability, and that it is the duty of the courts, as guardians of the constitutional standard, to determine in point of law whether the claims in suit meet that standard.

In short, conclusions of non-obviousness, labelled as fact-findings, are not conclusive under F. R. Civ. P. Rule 52(a) but require review as conclusions of law.

We submit that the court below committed reversible error in holding that the district court's findings of fact are conclusive of patentability, and in failing to determine *in point of law* whether "the differences between the prior art and the claims in suit" were obvious or non-obvious by the constitutional standard of invention.

Question II

A basic error in the District Court's opinion was its failure to compare the prior art with the claims in suit in determining obviousness and patentability. As stated above (*supra* p. 4), the district judge did not compare the prior art with the patent claims. On the contrary, he compared it with his own characterization of "the invention here involved", based on what "the patent in suit discloses" and consisting of features none of which are recited in the claims. In this he committed clear error.

". . . [C]laims particularly pointing out and distinctly claiming the subject matter which the applicant regards

as his invention" (35 U. S. C. § 112, 2nd paragraph) are the very heart of the patent.

This Court said in *Graver* (336 U. S. 271, at p. 277):

> ". . . We have frequently held that it is the claim which measures the grant to the patentee. See, for example, *Milcor Steel Co.* v. *Fuller Co.*, 316 U. S. 143, 145; *General Electric Co.* v. *Wabash Co.*, 304 U. S. 364, 369; *Altoona Theatres* v. *Tri-Ergon Corp.*, 294 U. S. 477, 487."

Graham applies that fundamental rule in construing § 103 as requiring that—

> ". . . differences between the prior art and the *claims at issue* are to be ascertained" (383 U. S. at p. 17, emphasis ours).

The error of the district court in failing correctly to apply this rule vitiates its findings as to non-obviousness of the subject matter actually claimed and infects the conclusion of the court of appeals based on those findings. If corrected, on review, it could have no other logical result, we submit, than to lead to reversal of the judgment on validity.

Question III

The courts below erred in construing the claims in suit without any reference to the reduction in the scope of the subject matter claimed during the proceedings in the Patent Office leading up to the grant. The history of the application for the patent in suit in the Patent Office demonstrates the trivial nature of the subject matter actually claimed as compared with that admitted to be unpatentable by abandonment of the original claims.

All of the original claims were rejected by the Examiner as unpatentable over the prior art (Pltf's. Exh. 1A, hand numbered page 17).

> ". . . To use an insert such as shown in Cross or Colby in a saber type saw such as is shown by Forsberg is not considered invention. It would only amount to a matter of mechanical skill to mount such an insert in the base plate 62 of Forsberg if desired."

Original claim 2 was then amended by inserting the words "free floating" before the phrase "limited lateral movement of the insert relative to the base plate" (Pltf. Exh. 1A, p. 20 and see p. 9). The amendment was accompanied by an argument in which the applicant's solicitor stated (Pltf's. Exh. 1A, p. 23):

> "Applicants wish to place particular emphasis upon the fact that the insert is free floating. This is very important . . ."

Claim 2 was thereupon allowed and all of the remaining claims cancelled. Two new claims were offered and allowed, both containing the "very important" words "free floating". These are the three claims in suit.

In its brief in the court of appeals (p. 8), plaintiff's counsel argued, contrary to the facts shown by the prosecution history, that:

> "The Patent Office did not regard the expression 'free floating' as a critical distinction or as any distinction."

Under the authority of *Graham* and cases therein cited, this history of the Patent Office proceedings reduces the subject matter of the claims to a triviality.*

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* This Court said in *Graham* (383 U. S. at pp. 32-4):

> "It is crystal clear that after the first rejection, Scoggin relied entirely upon the sealing arrangement as the exclusive patentable difference in his combination. It is likewise clear that it was on that feature that the Examiner allowed the

(Footnote continued on next page)

While the defense of file wrapper estoppel is more often applied in determining non-infringement, limitations on the definition of the invention, self-imposed in order to distinguish it from claims abandoned as being unpatentable, are no less applicable in determining validity, which is precisely what this Court did in *Graham* (at pp. 22-4 and pp. 33-4). And see *AMP* v. *Burndy* (3 Cir. 1964) 322 F. 2d 236, 238 (2nd column).

Neither the district court nor the Court of Appeals paid any attention to the prosecution history in determining the

(Footnote continued from preceding page)

claims. In fact, in a letter accompanying the final submission of claims, Scoggin, through his attorney, stated that 'agreement was reached between the Honorable Examiner and applicant's attorney relative to *limitations* which must be in the claims in order to define novelty over the previously applied disclosure of Lohse when considered in view of the newly cited patents of Mellon and Darley, Jr.' (Italics added.)

* * *

"It is, of course, well settled that an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office. *Hogg* v. *Emerson,* 11 How. 587 (1850); *Crawford* v. *Heysinger,* 123 U. S. 589 (1887). Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent. *Powers-Kennedy Co.* v. *Concrete Co.,* 282 U. S. 175, 185-186 (1930); *Schriber Co.* v. *Cleveland Trust Co.,* 311 U. S. 211, 220-221 (1940).

"Here, the patentee obtained his patent only by accepting the limitations imposed by the Examiner. The claims were carefully drafted to reflect these limitations and *Cook Chemical is not now free to assert a broader view of Scoggin's invention. The subject matter as a whole reduces, then, to the distinguishing features clearly incorporated into the claims.*" (Emphasis ours.)

subject matter claimed.* Under the law, this constituted reversible error. It demonstrates that the courts below failed to construe the claims in the light of the prosecution history, failed to give effect to the self-imposed limitation and failed to recognize that the subject matter of the patented claims was thus reduced to a trivial distinction (admittedly non-critical) over the rejected claims which by their cancellation, were acknowledged to be unpatentable.

The dissenting judge, in the Court of Appeals, properly rested his opinion, both as to invalidity and non-infringement, on this file wrapper limitation and its effect in reducing the alleged invention to a mere matter of mechanical skill (App. 6a).

Here, again, the majority below committed reversible error of law which should be reviewed and corrected.

Conclusion

We submit that a writ of certiorari should be granted to review these errors of the court below.

1. Error in affirming validity on the basis of fact findings alone without judicial determination that the subject matter claimed satisfies the constitutional requirement of invention.

2. Error in affirming the district court's finding of non-obviousness without any comparison of the prior art with the subject matter actually claimed.

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* In the section on "Indefiniteness" in the district court's opinion, reference is made to this prosecution history solely in determining the meaning of the terms (App. 31a-33a). The court's statement (App. 32a):

> "that the word 'floating' was used as a synonym for 'move'"

confirms the triviality of the added limitation.

3. Error in ignoring the prosecution history of the patent in suit in determining the subject matter of the claims and its obviousness in the light of the prior art.

Respectfully submitted,

.....

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Dated: December 4, 1968

APPENDIX

Opinion of the United States Court of Appeals for the Fourth Circuit, Filed September 13, 1968

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 12,174

THE PORTER-CABLE MACHINE COMPANY,
and ROCKWELL MANUFACTURING COMPANY,
Appellees,

v.

THE BLACK AND DECKER MANUFACTURING COMPANY
Appellant.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MARYLAND, AT BALTIMORE.
ALEXANDER HARVEY, II, DISTRICT JUDGE.

(Argued June 20, 1968. Decided September 13, 1968.)

Before BOREMAN, BRYAN and CRAVEN, Circuit Judges.

ALBERT V. BRYAN, Circuit Judge:

Infringement of patent 2,842,170, issued July 8, 1958, for a portable, powered saber saw (jigsaw) is here charged by the owner, The Porter-Cable Machine Company against The Black and Decker Manufacturing Company. Besides traversing the imputation, the defense also denies the patent's validity, saying that it was granted on the application of one not the originator of the alleged invention, and also

that it suffered from obviousness, overclaiming and indefiniteness. 35 USC 102, 103, 112.

Overruling these pleas the District Court in a comprehensive opinion, *The Porter-Cable Machine Company, et al.* v. *The Black and Decker Manufacturing Co.*, 274 F. Supp. 905, (D. Md. Oct. 23, 1967) sustained Nos. 1, 2 and 3 of the patent's claims, the remaining claim having been withdrawn. Also, the Court saw infringement and decreed appropriately towards recoupment of damages. On Black and Decker's appeal we decline to disturb the trial court's findings and conclusions.

The saw in suit is small enough to be held and applied by hand, very much as a manual clothes pressing iron. Sketchily, the components of it here relevant are a housing enclosing a motor and having a handle attached atop of it, the whole resting on a metal base plate, and a vertical serrated blade located near the front of the housing, extending downward from the motor, and moving up and down through a recess or slot in the front end of the base. The tool gets the name of saber or bayonet from the fact that the blade-end away from the motor is unattached.

In use the base of this kind of saw is pressed upon—over or under—the material to be cut. With the unit pushed forward, the rapidly descending and ascending toothed edge of the blade cuts the material as the recess in the base passes along the surface of the material. The experience was that when the blade engaged the edge of the work piece, especially when composed of layers, such as plywood, some splintering or chipping of it frequently occurred despite the pressure upon it of the base on each side of the recess to hold it firm while being cut. In part this was due to the flexibility of the blade because the far end of it was free and unattached. Solution of this problem was the desideratum of the patent. The corrective means utilized was

to place a metal insert in the inner end of the recess to confine the play of the blade without restricting its movement. Inventiveness is claimed in the design and operation of the insert.

Determination of this controversy called for resolution of the issues of prior art, anticipation, utility, obviousness and infringement. Confessedly, they present close questions. The others—overclaiming and indefiniteness—may be discarded as insubstantial. These controlling inquiries are factual, as *Graham* v. *John Deere Co.*, 383 US 1, 17 (1966) declared:

> "While the ultimate question of patent validity is one of law, *A. & P. Tea Co.* v. *Supermarket Corp.*, *supra*, at 155, the § 103 condition, which is but one of three conditions [non-obviousness, utility and novelty] each of which must be satisfied, lends itself to several basic *factual* inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. . . ."

That infringement, too, as a matter of fact is generally agreed. *Graver Mfg. Co.* v. *Linde Co.*, 339 US 605, 609 (1950); *Hazeltine Research* v. *Admiral Corp.*, 183 F. 2d 953, 955 (7 Cir. 1950).

Literally, therefore, decisions upon these issues come within the commandment of Rule 52 F. R. Civ. P., that we

honor them unless clearly in error. Here the rule is significantly nerved and inspirited by the judicial scrutiny and deliberation from which the findings evolved. The pattern for decision prescribed in *Graham* v. *Deere, supra,* 383 US 1 was pursued almost ad verbum. The primary inquiries there directed were exhausted by the District Judge who arrayed and measured the evidence on each. Secondary considerations were also appraised. These included the outstanding but previously unanswered need for a remedy for the splintering or chipping, the earlier ineffectual efforts to find a correction and the apparent operational success of the patented article, as indicated by its commercial success. Then was added the statutory presumption of validity. 35 USC 282.

Likewise the Court looked carefully at appellant B and D's devices accused of infringing. They were inserts too, respectively designated as the original and a revised one, and appeared in three models of the power-operated manual saws manufactured by B and D. Their placement and operation corresponded to Porter-Cable's insert, although there were some differences in the design and material of them. The District Judge carefully explained and demonstrated this similitude.

Resolution of the issues in the case required and received painstaking study. Without a jury, the trial occupied six days; both experts and pragmatists gave evidence to the critical points of the claims. The stature of the "clearly erroneous" rule is heightened in these circumstances. As the Court said in *Graver Mfg. Co.* v. *Linde Co.,* 336 US 271, 274 (1949):

> "Rule 52(a) of the Federal Rules of Civil Procedure provides in part: 'Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses.' To no

> type of case is this last clause more appropriately applicable than to the one before us, where the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. This trial occupied some three weeks which, as the record shows, the trial judge visited laboratories with counsel and experts to observe actual demonstrations of welding as taught by the patent and of the welding accused of infringing it, and of various stages of the prior art. He viewed motion pictures of various welding operations and tests and heard many experts and other witnesses. He wrote a careful and succinct opinion and made findings covering all the factual issues."

From these foundation facts, patentability of the device in suit soundly follows as a conclusion of law, and the declaration of infringement must also be upheld.

Affirmed.

CRAVEN, Circuit Judge, dissenting:

The Examiner rejected all of Porter's claims for the reason that to "use an insert such as shown in Cross or Colby in a saber type saw such as is shown by Forsberg is not considered invention. It would only amount to a matter of mechanical skill to mount such an insert in the base plate * * * of Forsberg if desired." Thereafter, Claims 1, 4 and 5 were cancelled and Claims 2 and 3 were amended by inserting the words "free floating" before the phrase "limited lateral movement of the insert relative to the base plate." It was argued to the Examiner that: "Applicants wish to place particular emphasis upon the fact that the insert is free floating. This is very important since when portable saws of this nature are to be commercially manufactured, it is impossible to make the tolerances on the parts of the saw such that no mis-alignment of the blade will re-

sult. Therefore, in order to compensate for this mis-alignment but at the same time prevent chipping of the work piece, any insert which is used with a portable saw of this type must be free to float or move laterally in the base plate."

On the next official action, the claims which included the "free floating" characteristic were allowed, but Claim 1, which simply called for an insert having capability of "limited movement relative to the base plate in a plane parallel thereto," was finally rejected and was cancelled by Porter.

There is nothing new in this patent unless it be the "free floating" insert. Inserts for various purposes, including facilitating sawing, are old. It does not seem to me to be invention to fit an insert loosely into the base plate of a saber saw. As one of Porter's own employees testified, "if this thing was going to work it had to be a loose fit * * *." Asked whether "it just seems perfectly obvious to you that it was necessary to have a loose fit between these parts?", the same witness replied, "That's right."

I am of the opinion that the claims in the patent are obvious to one skilled in the art and anticipated by the prior patents discussed in the opinion of the district court. *Porter-Cable Mach. Co.* v. *Black & Decker Mfg. Co.*, — F. Supp. —, (D. Md. Nov. 3, 1967).

If the patent be deemed valid, I would hold it not infringed by Black and Decker's saber saw and its insert. This insert is of a flexible material which is squeezed or depressed into the socket. It is a tight fit rather than a loose fit although the softness and resilience of the material permits a giving way to the motion of the saw blade. Certainly it does move laterally nor float freely. File wrapper estoppel bars the application of the doctrine of substantial equivalents. *Carter Prods., Inc.* v. *Colgate-Palmolive Co.*, 269 F. 2d 299 (4th Cir. 1959).

Judgment, Entered September 13, 1968

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 12,174

THE PORTER-CABLE MACHINE COMPANY, and
ROCKWELL MANUFACTURING COMPANY,
Appellees,

vs.

THE BLACK & DECKER MANUFACTURING COMPANY,
Appellant.

Appeal from the United States District Court for the .....District of .....Maryland.

This cause came on to be heard on the record from the United States District Court for the.....District of .....Maryland....., and was argued by counsel.

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court appealed from, in this cause, be, and the same is hereby, affirmed with costs.

SAMUEL W. PHILLIPS
Clerk

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

THE PORTER-CABLE MACHINE COMPANY and ROCKWELL MANUFACTURING COMPANY,
Plaintiffs,

v.

THE BLACK AND DECKER MANUFACTURING COMPANY,
Defendant.

Civ. A. No. 13791.

United States District Court
D. Maryland.
Oct. 23, 1967.

HARVEY, District Judge:

In this action, the plaintiffs claim infringement of United States Patent No. 2,842,170 issued on July 8, 1958 and assigned by the named inventors to The Porter-Cable Machine Company, a New York corporation with its principal place of business located in Syracuse, New York. The patent in suit is for a saber saw structure, a saber saw being a portable, power-operated, hand-manipulated saw using a reciprocating saw blade, supported at only one end.[1]

In 1960, this patent was reassigned to one of the plaintiffs herein, The Porter-Cable Machine Company, a Delaware corporation with its principal place of business in Pittsburgh, Pennsylvania.[2] Thereafter, the latter corporation

[1] A saber saw is sometimes also called a bayonet saw, a jigsaw or a scroll saw. However, in a conventional jigsaw or scroll saw, the blade is supported at both ends.

[2] Both the New York corporation and the Delaware corporation will be termed "Porter-Cable" in this opinion. Before 1960, such designation will refer to the New York corporation and after 1960 to the Delaware corporation.

was merged into its parent, Rockwell Manufacturing Company which has been added as a party plaintiff and is now owner of the patent in suit. The plaintiffs seek an injunction against infringement of the patent, an accounting, damages and other relief.

The defendant is The Black and Decker Manufacturing Company, a competitor of Porter-Cable, located in Towson, Maryland. Defendant asserts the usual defenses of invalidity and non-infringement and in particular contends that the patent in suit is invalid (a) because the alleged invention was devised by one not named as the inventor; (b) because of obviousness; (c) because of overclaiming, and (d) because of indefiniteness of its claims.

The Patent in Suit

Only claims 1, 2 and 3 of the patent are still before the Court, claim 4 having been withdrawn by the plaintiffs. These claims are as follows:

> "1. A saber saw structure comprising a base plate adapted to be moved on the surface of the work piece and being formed with an opening, a housing mounted on the base plate, a saw blade holder mounted for vertical reciprocation in said housing toward and from the base plate, a vertically disposed saw blade carried by said holder and extending downwardly through the opening in the base plate and being formed with teeth on its forward edge for cutting the work piece on its stroke toward the base plate, an insert positioned on said plate in registration with said opening therein, said insert having a surface extending substantially flush with the work engaging surface of the base plate and being formed with a saw blade receiving aperture positioned in close proximity to the sides of said

saw blade, and said insert and base plate having means cooperable to detachably secure said insert to the base plate against vertical movement of said insert, said attaching means providing free floating limited lateral movement of said insert relative to the base plate.

"2. A saber saw structure as defined in claim 1, wherein the aperture in said insert is in the form of a slot extending inwardly from one edge thereof, and the insert being arranged on the base plate with the closed end of said slot confronting the back edge of the saw blade.

"3. A portable, power-operated, saber saw structure comprising a base plate adapted to engage the surface of the work piece and being formed with an opening having forward and rear portions and spaced apart side walls, a housing mounted on the base plate, a saw blade holder mounted for reciprocation in said housing toward and from the base plate, a saw blade carried by said holder and extending downwardly through the opening in said base plate, an insert, the side walls of the forward portion of said opening in the base plate being spaced apart to receive said insert, said base plate at the rear portion of said opening therein and said insert being provided with a tongue and groove formation for slidably interlocking the insert to the base plate, said tongue and groove formation being dimensioned to provide for limited free floating lateral movement of said insert relative to the base plate, said insert being formed with a saw blade receiving slot with the side walls thereof extending in close proximity to the sides of the blade and the closed end of the slot confronting the back edge of the blade, whereby the blade serves to maintain the insert in said rear por-

tion of the opening in the base plate and the tongue and groove formation in interlocking relation."

In describing the nature of the saber saw structure here involved, the specifications of the patent in suit note that the cutting edge of the saw blade is shaped to cut the material upon movement of the blade through the apertured base plate in a direction toward the housing. In other words, the base plate and the attached housing are placed on top of the work, and the saw blade cuts on the upstroke, pulling the material being cut against the base plate during such cutting stroke.

It is further stated in the specifications that saws of this general type have been developed as portable hand-manipulated machines for use for many cutting operations and that such machines are particularly advantageous in cutting panel material used for interior trim, table tops and the like. According to the specifications, such cutting tools universally have one disadvantage in that they chip the surface of the material engaged by the base plate of the machine. This chipping is caused by the teeth of the blade pulling upwardly or outwardly through the surface of the material being cut and when such material is used for cabinet work and the like the chipped edge is particularly unsightly. In machines of this type it is not practical to make the aperture in the base plate close-fitting to the sides of the saw blade due to variations and inaccuracies in the machining of parts of the machine, variations in the thickness of the blade used and lateral vibration of the blade during the cutting operation.

The specifications recite that the invention has as an object a saber saw structure embodying an arrangement effective to prevent chipping of the work piece by the saw blade. The invention has as a further object a power-operated saber saw structure including an insert mounted

in the base plate and having free lateral movement relative to the base plate, the insert being formed with a saw blade receiving slot, the side walls of which extend in close proximity to the sides of the saw blade.

It is defendant's position that the sole point of novelty in the invention, if any, is the loose or free floating fit of the insert in the base plate. Plaintiffs contend that the invention encompasses the entire combination, including the attaching means of the insert to the saber saw structure and the free floating yet secured relationship of such insert to the base plate.

History of the Patent

During the period of the matters in suit, Porter-Cable and Black and Decker both produced a line of power-operated, woodworking tools. In 1953, Porter-Cable had a comprehensive line of power tools for sale to the professional woodworker except that it did not have among its products a portable, power-operated saber saw. At that time the outstanding saber saw in the field was the Scintilla (or Scinta), which was manufactured by a Swiss firm.

Late in 1953, Porter-Cable undertook to develop a portable saber saw which would surpass the Scintilla in performance. Two different saws were developed by its engineering experimental department: one, the so-called Papworth saw, developed under the direction of an employee named Walter Papworth, and the other, the so-called Bruck-Mittins saw, developed under the direction of John P. Bruck, a design engineer, with the assistance of Frank W. Mittins, an employee in Porter-Cable's engineering experimental department. Like the Scintilla saw, the Papworth saw employed a traditional reciprocating blade motion whereby the blade moved up and down in the same plane, cutting on the upstroke. However, the Bruck-Mittins

saw adopted the novel concept of orbital motion. Orbital motion moves the blade into the work on the upstroke and backs it away on the return stroke, increasing the speed and ease of cutting. In spite of these marked advantages over the Scintilla saw, there was one substantial disadvantage which tests revealed would make the new orbital saw unacceptable to the public. Because of the aggressive action of the orbital motion, this saw badly splintered the veneer of the wood on the top of the work, and especially of plywood, which is a material customarily cut by saber saws. This splintering defect (termed "catastrophic" by one of plaintiffs' witnesses) caused the sales department of Porter-Cable to refuse to accept and market the Bruck-Mittins saw as originally presented around the first part of 1954.

Thereupon, Bruck and Mittins were assigned the task of curing the splintering defect. As early as June of 1954, they had developed the concept of using an insert to hold the fibers down while the saw blade was doing the cutting. By October 15, 1954, as noted by Mittins in an experimental report, a brass insert had been developed and tested with satisfactory results. A later experimental survey report dated November 8, 1954, compared tests of the Bruck-Mittins orbital saw with the Papworth and another reciprocating saw, noting that "the orbital tool, with the 'floating brass insert' seems to produce a slightly better cut as the insert tends to hold the wood fibers down while the blade is cutting." This report further stated:

> "In order to afford more bearing surface on either side of the blade, the Orbital saw has a removal *(sic)* brass insert which fits easily into the opening of the base. This tends to reduce chipping considerably (to a point whereby the saw cuts smoother than either of the 2 reciprocating saws), and was looked upon by the dealers as a good feature."

However, the report noted that the brass insert "wears" and suggested that the engineering department check this latter disadvantage.

After a review of this experimental survey, the Porter-Cable management decided to market the Bruck-Mittins saw using the newly-developed floating insert and to dispense with the Papworth saw. In subsequent months, certain refinements in the insert were made including the use of steel rather than brass to avoid excessive wear, and in January of 1956 the saw was introduced commercially as Porter-Cable Model 148 at a price of $99.52.[3] On January 18, 1956, an application for a patent was filed with the United States Patent Office with Bruck and Mittins being named as the inventors.

In that first year, more than ten thousand saws having a retail value of over one million dollars were sold. In subsequent years, Porter-Cable introduced other models embodying the Bruck-Mittins concept, including the Model 152 and the Model 548. In 1957, 12,264 saws of these types were sold; in 1958, 21,993; and in 1959, 23,886.

By June of 1958, large quantities of Models 148, 152 and 548 had been marketed by Porter-Cable. In that month, a survey of competing saws was undertaken by Black and Decker, which did not at the time have a competitive saber saw on the market. An evaluation report dated June 9, 1958 noted the good finish cut provided by Porter-Cable's insert and further noted that Porter-Cable's saw was "the only orbital motion unit that does a good job of scroll cutting with a taper ground blade."[4]

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[3] This price effectively limited the market to the professional user.

[4] Scroll cutting involves intricate design work, including curved cuts of varying radii, and is one of the important uses of a saber saw.

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

Black and Decker's first attempt to compete successfully with Porter-Cable was by decreasing the slot width in the base of its functional model saw. In November, 1959, Black and Decker advertised for marketing its U-40 orbital saw which had a narrow slot and no insert in its base. Some U-40 saws of this design were manufactured, but none were ever sold. Subsequently, the U-40 was compared with the Porter-Cable and other competitive saws, and it was decided at a meeting held on February 26, 1960, that Black and Decker's model should be improved before it was manufactured in quantity. The minutes of the meeting of Black and Decker's Product Development Committee held on that date in particular noted that the Committee "would like to see improvement of splintering the top surface while cutting plywood."

George W. McCarty, Black and Decker's Vice President in charge of research and development, was assigned the task of working on the shoe design of the U-40 to minimize splintering. McCarty sketched proposed solutions to the problem, one of such solutions being a rough copy of the Porter-Cable insert. Less than a month later, by March 13, 1960, a production drawing of an insert suggested by McCarty was produced. Thereafter, the U-40 was equipped with the Black and Decker insert and marketed. On August 25, 1960, an application for a patent was filed for a "self-aligning, anti-splintering insert for shoe of jigsaw," with McCarty being named as the inventor. Patent No. 2,996,089 was issued on August 15, 1961, showing an insert rectangular in shape (compared to the circular form of the Bruck-Mittins insert).

When it learned that the modified U-40 saw equipped with the McCarty insert was being sold on the open market, Porter-Cable notified Black and Decker by telephone and later by letter dated January 27, 1961 of the Bruck-

Mittins patent, claiming that Black and Decker was infringing. Porter-Cable also offered to enter into a license agreement with Black and Decker covering the Bruck-Mittins patent, and a copy of a proposed agreement was enclosed in such letter.

Black and Decker declined such offer and immediately set to work to develop yet another insert. About a month later, in March of 1961, production drawings were completed for this new insert, which was roughly rectangular in shape with rounded ears at the inner end. An application for a patent for an "anti-splintering resiliently retained insert for shoe of jigsaw" was filed on August 15, 1961 with George W. McCarty and Allen C. Stanley named as inventors. The patent was issued July 24, 1962, being No. 3,045,725. This new insert was incorporated in Black and Decker's Models U-251 and U-351 saber saws which were thereafter marketed. In May of 1962, Porter-Cable filed this suit for infringement.

Prior Art

By way of patent anticipation, Black and Decker offered in evidence copies of the following sixteen United States patents:

Inventor	*Device*	*Number*	*Issuance Date*
Fiedler	Filing Machine	75,402	March 10, 1868
Wells	Machine for cutting cloth	117,352	July 25, 1871
Schleicher	Circular Sawing-Machine	202,668	April 23, 1878
Dearing	Machine for cutting patterns	399,847	March 19, 1889
Edwards	Power feed sawing machine	447,812	March 10, 1891

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

Inventor	*Device*	*Number*	*Issuance Date*
Deniston	Throat-piece for scroll or other saws	461,325	October 13, 1891
Steinman	Reciprocating cutter	1,164,669	December 21, 1915
Colby	Cutting and sawing device	1,502,088	July 22, 1924
Hastings	Portable electric saw	1,542,127	June 16, 1925
Hutchinson	Woodworking machine	1,608,696	November 30, 1926
Cross	Scroll saw	1,975,314	October 2, 1934
Tautz	Machine Table insert	2,020,222	November 5, 1935
Bcice	Jigsaw	2,107,174	February 1, 1938
Christie	Work-supporting adjustable mandrel for band saws	2,472,570	June 7, 1949
Forsberg	Motor driven reciprocating saw	2,639,737	May 26, 1953
Papworth	Portable power driven reciprocable cutting tool	2,775,272	December 25, 1956

Only seven of these were cited as references in the file of this patent, namely, Dearing '847, Deniston '325, Steinman '669, Colby '088, Cross '314, Christie '570 and Forsberg '737.

In addition, defendant introduced in evidence and relied on a German patent (Kramer, No. 826,640, dated January 3, 1952), a Deltacraft publication of the Rockwell Manufacturing Company, and the August, 1945 issue of *Popular Mechanics* in support of its defense of anticipation.

Because of the great number and variety of the devices relied upon by defendant, it is not possible to analyze and discuss each of these separately and in detail, nor is it

necessary to do so for the reasons hereafter assigned. Each of these nineteen exhibits was discussed by witnesses and by counsel during argument. Colored charts and also models of a number of these devices were introduced in evidence at the trial. The Court has had an opportunity to examine the models and to review the patents, charts and other exhibits in the light of the arguments and the briefs, and to compare them with the patent in suit. The finding of the Court is that the patent in suit is valid in view of the state of the prior art.

It should be noted for a full understanding of the nature of the invention here involved that the patent in suit discloses a hand-manipulated power saw with the blade operating with orbital motion which cuts on the upstroke, resulting in a splintering problem on the upper side of the work surface.[5] Many of the prior patents relied upon by the defendant are obviously inapplicable because they relate to devices with entirely different uses than the one here involved. For example, Wells '352 discloses a machine for cutting cloth with the cutting element being in the form of a band saw.[6] Separate plates are mounted on the platform at opposite sides of the slot through which the saw passes. The plates yield slightly to the side whenever cloth is dragged down into the slot by the cutter. Obviously, there is no anti-splintering function to these plates as cloth is the material being cut instead of plywood.

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[5] The defendant argues that neither the patent nor the specifications mention or describe orbital motion. However, it is clear from the specifications that the invention relates to a reciprocating type saw blade which cuts on the upstroke with resultant chipping on the top surface of the work. Furthermore, the specifications incorporate by reference an earlier Bruck patent, No. 2,737,987, which does describe orbital motion in some detail.

[6] A band saw consists of an endless band or belt of metal sharpened at one or both edges to cut the material.

Similarly, Fiedler '402 (a patent granted almost 100 years ago), is described as a machine for filing wood or iron "at different angles."[7] The specifications state that the wood to be filed should lie solid and close to the file to prevent the file from "tearing the wood." The patent does not state that the sliding plate (which defendant relies upon as being similar to the Porter-Cable insert) is in any way designed to prevent tearing of the wood. It is also clear that when the table is tilted, as it was designed to do, the plate would have to be clamped to prevent its sliding into contact with the teeth, thus eliminating any float or looseness.

Other examples of prior art relied upon by defendant are equally inapplicable. Neither Schleicher '668 nor Edwards '812 (both of which disclose a circular saw) suggest any anti-splintering function. Dearing '847 is designed to cut fabrics, leather or similar material on the down stroke. Hastings '127 discloses the first true saber saw in the prior art, but does not have an anti-splintering insert. Hutchinson '696 (a stationary woodworking machine using a circular saw blade), Tauts '222 (a circular bench or table saw), and Boice '174 (a conventional jigsaw of the stationary type with the saw blade supported at both ends and having a tilting work table) all do not contain any reference to anti-splintering. Both Steinman '669 and Christie '570 were introduced in evidence by defendant solely because they were patents cited by the Examiner. They appear to have little pertinency to the issues in this case and are not seriously relied upon by defendant.

The most pertinent references would appear to be Deniston '325, Colby '088 and Forsberg '737. The Deniston patent, which was one of those cited by the Patent Office, is the only exhibit which discloses a mechanical device for

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[7] Although this patent is for an "Improved Filing Machine," it is noted that the machine can also be used for sawing.

preventing splintering of the surface of work cut by a saw. However, Deniston does not disclose a true saber saw inasmuch as the saw blade is supported at both ends. Furthermore, Deniston cuts on the down stroke and any anti-splintering function would, therefore, relate only to the underside of the work. As contrasted with the patent in suit, in Deniston, the work is placed on top of the throat piece. Although the specifications state that the special purpose of the throat piece is to prevent tearing or breaking out of the wood on the underside of the piece worked by the saw, the evidence discloses that when the wood is placed on top of the throat piece the forward portion is depressed and any anti-splintering effect is reduced or eliminated. Defendant's witness McCarty conceded on cross-examination that as a result of the depression of the throat piece by the work on top, the Deniston concept would not be effective as far as anti-splintering is concerned inasmuch as the fibers of the work piece would be too far away from the point where the teeth of the blade emerge. He followed up such testimony by stating that it would be possible to alter the Deniston patent to provide an anti-splintering effect. It is clear therefore that although the Deniston patent recognizes the anti-splintering problem, it does not furnish an adequate solution along the lines suggested by the patent in suit. The insert disclosed here in the patent in suit, although retaining the advantages of being free floating, is so assembled as to remain during use in close proximity to the place where the teeth of the blade emerge from the work. When the machine is used in Deniston and the work is placed *on top* of the device, the opposite result obtains, as the forward portion of the throat piece is depressed and the throat piece is pushed away from the critical point where the teeth of the blade emerge.

Colby '088, also cited by the Patent Examiner, discloses a true saber saw, although in its normal use it differs from

the patent in suit in that it cuts on the down stroke. There is no disclosure in the Colby patent of any anti-splintering device or function. Furthermore, the use of the keyhole aperture in the Colby insert defeats or lessens any anti-splintering effectiveness that the device might have.

Forsberg '737 discloses the first saber saw manufactured and sold in the United States. Although the patent shows a motor-driven reciprocating saw, it does not disclose an insert, a base capable of receiving an insert, nor an attaching means to hold the insert in place and retain it against undesired movement. For the purposes of this case, Papworth '272 may be considered to be identical to Forsberg.

The German patent discloses a tiltable and rotatable band saw table, having a hard wood disc insert with a normal fit so as to be easily removable. There is no disclosure of any anti-splintering function either in this patent or in the Rockwell Manufacturing Company publication which shows a conventional band saw and a conventional stationary jigsaw.

The *Popular Mechanics* publication in evidence is entitled "You Can Build This Sturdy Scroll Saw." It discloses an insert to be fitted within a table opening and specifies a free fit to permit insertion and removal of the insert. The article calls for a slot in the insert of one-quarter of an inch in width. The testimony indicates a slot of such width would have very little if any anti-splintering effect, nor does it appear that the insert was designed for any such purpose.

In summary then, although defendant has put in evidence in this case a great many examples of devices involving various types of saws or cutting machines, none of these devices either alone or in combination are sufficient to anticipate the invention which resulted in the patent here

in suit. The volume of the prior art relied on by the defendant is in itself evidence of the weakness of its position. As the Fourth Circuit Court of Appeals said in *Reynolds* v. *Whitin Mach. Works,* 167 F. 2d 78, 83-84 (4th Cir., 1948); cert. den. 334 U. S. 844 (1948):

> "Defendant has cited 21 patents as basis for its contention that complainants' invention is lacking in novelty; and this in itself is evidence of the weakness of the contention. Such a citation of so many prior patents almost always means either that none of them is in point and that the patentee has brought together for the purpose of his invention devices to be found in prior patents of different character, or that there have been prior attempts to solve the problem with which he was confronted which have not met with success. * * * [citations] * * * *Patents for useful inventions ought not be invalidated and held for naught because of such excursions into the boneyard of failures and abandoned experiments.*" (Emphasis added.)

Validity

35 U. S. C. A. § 282 provides that a patent shall be presumed valid and that the burden of establishing invalidity rests upon the party asserting it. As Judge Watkins said in *Collins* v. *Kraft,* 144 F. Supp. 162 (D. Md., 1956), at page 168:

> "The statutory presumption of validity from the issuance of a patent means that 'the burden of proving want of novelty is upon him who avers it * * * but his burden is a heavy one, as it has been held that "every reasonable doubt should be resolved against him"' *Mumm* v. *Jacob E. Decker,* 1937, 301 U. S. 168, 171, 57 S. Ct. 675, 676, 81 L. Ed. 983."

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

(a) *The Named Inventors*

A patent is invalid if granted on the application of a person who was not in fact the original and first inventor of the improvements purporting to be covered by the patent. 35 U. S. C. A. § 102; *Sanford Inv. Co.* v. *Crab Orchard Improvement Co.*, 25 F. Supp. 575 (S. D. W. Va. 1938), affirmed 104 F. 2d 347 (4th Cir., 1939). 35 U. S. C. § 115 provides that the applicant for a patent shall make oath that he believes himself to be the original and first inventor of the device for which he solicits a patent.

Defendant claims that the actual inventor here was Dane Pedersen and not John P. Bruck and Frank W. Mittins who were named as inventors in the patent in suit. The evidence on this issue is conflicting. However, the granting of letters patent raises a prima facie presumption that the named persons were inventors of the patented device, and the burden is upon the defendant to show otherwise by strong, clear and convincing evidence. *Pacific Scientific Company* v. *Aerotec Industries of California*, 243 F. Supp. 390 (S. D. Cal. 1965).

On September 27, 1963, the deposition of Dane Pedersen was taken by the attorneys for the defendant in this case. Portions of this deposition have been admitted in evidence. Pedersen, whose employment was terminated in 1961, was originally hired by Porter-Cable as a technician in 1950, and he was performing such duties in 1955. Pedersen stated that he worked closely with Bruck in connection with the development of this saber saw. He conceded that Bruck was "the designer" of the saw, but said that after Bruck left the Company in March of 1955, he, Pedersen, was asked to improve on the idea of the insert. Pedersen testified that shortly before June of 1955 he accidentally discovered the effectiveness of mounting the insert in such a way that it would permit free floating lateral movement.

He further testified that as far as he knew, Mittins did not contribute anything to the design of the insert.

In further support of its position that Bruck and Mittins were not the true inventors, defendant relies on the deposition testimony of Mittins himself which also was admitted in evidence at the trial. Mittins was deposed on May 23 and 24, 1963. He testified that shortly before June of 1955 he worked with Bruck and helped Bruck develop the insert in the form in which it was finally patented.[8] Inasmuch as it is not disputed that Bruck left the employ of Porter-Cable in March of 1955, defendant argues that on the basis of Mittins' testimony the concept of the loose fit must have been developed after Bruck left and that therefore Bruck was not one of the inventors.

Contrasted with this testimony taken by way of deposition is the testimony in court of Matthew Patulski, that the invention was substantially complete by November, 1954.[9] Such testimony is supported by the experimental report dated November 8, 1954 which clearly indicates that the floating insert had been developed by that date and that only minor modifications were required thereafter.

Lloyd B. Benham, Porter-Cable's Vice President in charge of Engineering, testified by way of deposition that Bruck and Mittins were the joint inventors. He based his conclusion on his day-to-day observation of their work. It should further be noted that both Bruck and Mittins took the formal oath attached to the original application that

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[8] Mittins therefore contradicts Pedersen's testimony that Pedersen alone first developed the idea of a loose fitting insert. Defendant states that as to this part of his testimony Mittins was "obviously mistaken."

[9] Patulski held two positions at the time: Manager of New Products Development and Market Research Manager.

they were the original, first and joint inventors of the saber saw structure covered by the patent.

In resolving this conflict in testimony, this Court notes that Mittins' deposition was taken some eight years after he was engaged in working on this invention. Both parties agree that Mittins is in error in testifying the Bruck was still with Porter-Cable in June of 1955 when Mittins says they were working on the invention. It does not necessarily follow from Mittins' recollection of events eight years before that Bruck had nothing to do with the basic concept of a loose fitting insert. A more reasonable explanation of the Mittins' testimony is that he recalled having worked with Bruck on the invention, but eight years after the work had been done, he could not precisely remember the date of such work and placed it in June of 1955 rather than in October or November of 1954.

Pedersen's testimony that he was the first one to develop the concept of the loose fit is contradicted by Mittins, Patulski, and Benham. Of even greater weight is the written Porter-Cable experimental report of November 8, 1954 which clearly shows that the idea of a floating insert had been developed by that date.

After careful consideration of the testimony and exhibits, this Court finds that, as shown by the weight of the credible evidence, Bruck and Mittins were in fact the original and first inventors of the improvements covered by the patent in suit. The defendant has produced no clear and convincing evidence to the contrary.[10]

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[10] Having conceded that Bruck was the designer of the saw, Pedersen can in any event claim to be no more than a joint inventor of the combination disclosed by the patent in suit. Misjoinder or non-joinder of a joint inventor does not invalidate a patent if the error can be corrected as provided in 35 U. S. C. A. § 256. That Section permits the Commissioner to make such a correction if a person not named in a patent was a joint inventor, but was omitted by error and without deceptive intention on his part.

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

(b) *Obviousness*

Two recent decisions of the Supreme Court discuss the requirement under 35 U. S. C. A. § 103 that a patent to be valid must be non-obvious, namely, *Graham* v. *John Deere Co.*, 383 U. S. 1 (1966), and *United States* v. *Adams*, 383 U. S. 39 (1966). As Mr. Justice Clark said in the *Graham* case, at pages 17-18:

> "While the ultimate question of patent validity is one of law, *A. & P. Tea Co.* v. *Supermarket Corp., supra,* at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."

It is clear that the validity of a patent turns on the facts of each particular case. *Graham, supra,* at page 5. As previously discussed, the prior art does not provide any obvious solution for the problem confronting Porter-Cable when it decided to explore the possibility of marketing a saber saw using orbital motion. Indeed, there is no indication that the problem itself had ever been presented in the frame of reference in which Bruck and Mittins undertook a solution. Splintering on the top surface of intricate

scroll work is a problem of much greater magnitude than splintering on the under surface of the material being cut. Use of a close-fitting, securely attached insert was no solution because of the difficulty in manufacturing parts of the saw (including the blades) with the extreme accuracy necessary for such a close fit. What was required was a device which though limited in movement, would move in all directions, laterally, backwards and forwards and up and down, but which would still furnish such firm support for the material at the point where the blade did the cutting that splintering would in effect be eliminated. Extensive experimentation and testing by Bruck and Mittins resulted in the invention of just such a device which, when combined with the other elements of a saber saw employing a reciprocating saw blade, constitutes the patent in suit.

Defendant's claim that the concept of the invention is a simple one and that it is obvious from the prior art is no more than the exercise of the "20-20 vision of hindsight." See *O. M. I. Corporation of America* v. *Kelsh Instrument Co.*, 173 F. Supp. 445, 457 (D. Md., 1959), affirmed 279 F. 2d 579 (4th Cir., 1960). As stated in *Florence-Mayo Nuway Co.* v. *Hardy*, 168 F. 2d 778, 781 (4th Cir., 1948):

> "Knowledge after the event is always easy, and problems once solved appear as never having presented difficulty."

As previously noted, defendant places considerable reliance on the deposition testimony of Pedersen which was admitted in evidence in this case. This Court has rejected such testimony in support of defendant's position that Pedersen was the true and only inventor. However, portions of Pedersen's testimony do serve to support plaintiffs' position that the invention was not an obvious one.

Pedersen was employed by Porter-Cable as a technician until 1955 and a research engineer until 1957. He claimed

in his testimony that the free floating mounting of the insert in the base plate was his discovery. As a person of ordinary skill in the art, Pedersen's first attempted solution of the problem was to reduce movement of the insert by actually fastening the insert to the base plate. Such an experiment proved unsatisfactory. Continued efforts finally resulted in a nylon insert and "by accident I found out that we had a lot of play in the blade moving back and forth". Having accidentally made the insert too loose, Pedersen noted that the insert operated more satisfactorily because of such motion.

As this Court has previously found, the free floating characteristic of the insert was developed in the fall of 1954 as a result of many months of experimentation by Bruck and Mittins. By accident Pedersen duplicated what had been discovered months before and successfully tested by his employer. Pedersen's testimony shows that the application of ordinary skill in the art not only would not lead to the invention as finally patented but in fact would lead in the opposite direction. That Pedersen fortuitously stumbled on the solution suggests that it was not an obvious one.

Not only does this invention contain the primary attributes of non-obviousness, but also it satisfies the secondary considerations of commercial success and immediate imitation. The marketing of a power saw embodying the invention here in suit met with instant and substantial commercial success. Furthermore, defendant at once undertook to imitate its competitor's successful product. When defendant's first response was challenged, it immediately abandoned this answer to the problem and set out to devise another and safer means of providing competition without facing liability for infringement. In other words, in this case defendant undertook to imitate its competitor's product not just once but on two separate occasions. This trib-

ute of imitation paid by the defendant buttresses the presumption of validity of the patent in suit. As Judge Watkins said in *O. M. I. Corporation of America* v. *Kelsh Instrument Co., supra,* at page 457:

> "* * * This Circuit has often emphasized the great weight, on the question of validity, that should be accorded the flattery of imitation; that the presumption of validity is further buttressed when the one attacking validity 'gives the tribute of its praise to the prior art' but gives to the patent 'the tribute of its imitation.' *Diamond Rubber Co. of New York* v. *Consolidated Rubber Tire Co.,* 1911, 220 U. S. 428, 441, 31 S. Ct. 444, 450, 55 L. Ed. 527; *Ackermans* v. *General Motors Corp.,* 4 Cir., 1953, 202 F. 2d 642, certiorari denied 1953, 345 U. S. 996, 73 S. Ct. 1139, 97 L. Ed. 1403, rehearing denied 1953, 346 U. S. 842, 74 S. Ct. 16, 98 L. Ed. 362; *Florence-Mayo Nuway Co.* v. *Hardy,* 4 Cir., 1948, 168 F. 2d 778, 782."

After considering all of the evidence presented, this Court concludes that the combination here clearly transcends the art of a skilled mechanic and it is this Court's finding that such combination amounts to a genuine invention.

(c) *Overclaiming*

Relying on *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 U. S. 545 (1938), defendant contends that plaintiffs' action in claiming old and separately usable elements of a tool in combination with the improved element renders the patent wholly invalid. In that case the Supreme Court said the following at pages 549-550:

> "* * * The mere aggregation of a number of old parts or elements which, in the aggregation, perform or

> produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination."

The evidence discloses that although there are old elements in the patent in suit, it is not composed entirely of an aggregation of old parts or elements.[11] The invention here includes new and improved elements which have been combined with the old and which in combination perform new and different functions than theretofore performed. As previously discussed in considering the prior art, the earlier patents nowhere disclose or suggest the entire combination making up the invention here, including base plate and housing, blade holder and saw blade, and insert and attaching means providing free floating limited lateral movement of the insert relative to the base plate.

Defendant argues that Porter-Cable should have sought to patent only the insert as did McCarty on two separate occasions. The simple answer to this contention is that the invention here is not the insert alone, but is in fact the entire combination including the insert as positioned in relation to the other parts of the saw. Unless the claims include the proper positioning of the insert in relation to the base plate and the saw blade so as to provide free floating limited lateral movement relative to the base plate, the invention cannot accomplish the objects set forth in the patent specifications.

When the Porter-Cable saw is used with the insert, the insert and the other elements of the saw are mutually in-

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[11] Even if a device is a mere combination of elements known in the prior art, it may be patentable when it produces a new and different result. *Heyl & Patterson, Incorporated* v. *McDowell Company,* 317 F. 2d 719, 722 (4th Cir., 1963).

terdependent and embody the patent. Claiming of the entire combination does not under such circumstances constitute overclaiming. Of course, when used without the insert to cut metal, plastic, tile or other materials that do not present a splintering problem, the saw is not covered by the claims of the patent in suit.

(d) *Indefiniteness*

It is provided in 35 U. S. C. A. § 112 that the specification of a patent shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. The statutory requirement of particularity and distinctness in claims is met when they clearly distinguish what is claimed from what went before in the art and clearly circumscribed what is foreclosed from future enterprise. *United Carbon Company* v. *Binney & Smith Co.*, 317 U. S. 228, 236 (1942).

The defendant contends that the claims of the patent in suit are invalid because they use the term "free floating limited lateral movement" at the exact point of alleged novelty of the invention. Particular emphasis is placed by defendant on the fact that the file wrapper of the patent in suit shows that the words "free floating" were inserted in the claim by amendment after the application had originally been rejected.

Examination of the record of the prosecution of the patent in suit discloses that the original application filed with the United States Patent Office on January 18, 1956 included five separate claims. On September 25, 1956, the Examiner rejected all five claims as being unpatentable. In three separate places the specifications stated that the insert had "free lateral movement" relative to the base plate. Claim 1 of the original application stated that the insert had "limited movement relative to the base plate in a plane parallel thereto"; claim 2 stated that the attach-

ing means provided "limited lateral movement of the insert", and claim 4 stated that the insert was mounted for "limited movement relative to the base plate in a plane parallel thereto". The drawings give examples of what was meant by free limited lateral movement.

An amended application was filed on January 2, 1957. Claims 1 through 5 were amended and new claims 6 and 7 were added. The word "floating" was used for the first time by insertion in the original claim 2 and was included in the new claims 6 & 7. In the patent attorney's argument in support of the amended application, it was made clear that the word "floating" was used as a synonym for "move" and further argument described the extent of the movement of the insert with respect to the base plate.

On October 22, 1957, the Examiner again rejected claim 1, allowed claims 2 & 3, rejected claims 4 & 5 as not being patentably distinct from claims 2 & 3, and rejected claims 6 & 7 as being indefinite in that there was no antecedent for certain terms used in these claims.[12] The Examiner stated that if claims 6 & 7 were amended to provide the necessary antecedents, these claims would probably be allowable. Thereafter, such amendments were submitted, resulting in the allowance of the four claims contained in the patent as issued on July 8, 1958, being claims 2, 3, 5 and 6 of the amended application.

Study of the file wrapper clearly discloses that the amended application included no change in the original concept of the invention. In the amended application claim 2 called for "free floating limited lateral movement of the insert" while claim 4 provided for "limited lateral movement". Obviously the Patent Examiner considered these two expressions as substantially the same in that claims 4 & 5 of the amended application were rejected as not being

[12] Such terms are not material to the issues in this case.

patentably distinct from the allowed claims 2 & 3. When considered in the light of the entire file, the addition of the words "free floating" in the amended application does not make the claims indefinite or indistinct. A number of different equivalent expressions were used to describe the concept and to distinguish what was claimed in the patent from what went before in the art.

Defendant's principal attack is directed toward the words "float" and "floating". Its position is considerably weakened by the fact that its own Vice President, McCarty, did not find these words indefinite but in fact used one or both of them in both of his patent applications. In the application which resulted in the issuance of McCarty '089, it was stated that "the insert 10 will be allowed 'to float' with respect to the blade 15". In the application for the later patent, McCarty '725, reference was made to "the continuous loose, lateral play of the insert, sometimes referred to as 'free floating' ", and the earlier Bruck and McCarty inserts were identified as of the "free floating" type.

For these reasons, this Court concludes that the claims here are sufficiently distinct to satisfy the requirements of 35 U. S. C. A. § 112. Even if there were some doubt in this regard as to the claims involved here, as the Fourth Circuit Court of Appeals said in *Reynolds* v. *Whitin Mach. Works, supra,* at page 85, this Court "would construe them in the light of the specification and drawings to save a meritorious patent". In *Lever Bros Co.* v. *Proctor & Gamble Mfg. Co.,* 139 F. 2d 633, 639 (4th Cir., 1943), the same Court noted that—

> "* * * inventors should not be deprived of their labors by a too technical nicety in the requirement that inventions must be adequately described to indicate their real scope and their true content."

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

Infringement

As previously noted, after the insert was developed which was later incorporated in McCarty '089, Black and Decker's U-40 saw was equipped with such insert and marketed. This insert will be referred to as the "original insert". After Porter-Cable claimed that the U-40 saw with the original insert infringed the patent in suit, another insert was developed and later patented as McCarty '725. This new insert, referred to herein as the "revised insert", was incorporated in Black and Decker's models U-251 and U-351 saws.

Plaintiff claims that both the original and the revised inserts infringe claims 1, 2 and 3 of the patent in suit. As stated in *Graver Tank Co.* v. *Linde Air Products Co.*, 339 U. S. 605, 607 (1949), if "accused matter falls clearly within the claim, infringement is made out and that is the end of it." Under the doctrine of equivalents, even if the accused structure avoids the claims when literally interpreted, it infringes if it performs substantially the same function in substantially the same way to obtain the same result. *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30, 42 (1929).[13]

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[13] Defendant, invoking the theory of file wrapper estoppel, contends that the doctrine of equivalents is in no way applicable to the present case, relying on *Carter Products, Inc.* v. *Colgate-Palmolive Company*, 269 F. 2d 299 (4th Cir. 1959). The argument that Porter-Cable is estopped by the position it took in the Patent Office from claiming that the invention is anything more than the loose fit of the insert in the base plate has been fully answered in earlier portions of this opinion, wherein this Court analyzed the record of the prosecution of the patent in suit and reached the conclusion that the amended application did not change the basic concept of the invention. File wrapper estoppel therefore does not apply in the present case.

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

(a) *The Original Insert*

As provided in the pretrial order, defendant has admitted that all of the elements and features of claims 1, 2 and 3 of the patent in suit are present in its accused saw when fitted with the original insert with the exception of the words "substantially flush" in claims 1 and 2, describing the relationship of the work engaging surface of the base plate and the insert, and the words "free floating" in all three claims, describing the movement of the insert relative to the base plate. It is further stipulated in the pretrial order that the bottom surface of the original insert, when fitted into the base plate of the U-40 saw, is between .010 inch and .015 inch below the work engaging surface of such base plate when assembled rather than co-planar therewith. Defendant argues that under such circumstances the original insert when fitted in its U-40 saw is not substantially flush with the work engaging surface of the base plate and, accordingly, does not infringe the patent in suit.

In the original application for the patent in suit, claim 1 (listed therein as claim 2), described the insert as "having a surface extending flush with the work engaging surface of the base plate * * *." In the amended application, the word "substantially" was added before the word "flush", and the reason for the change was stated as follows:

> "Claim 2 has been amended to locate the bottom surface of the insert substantially flush with the bottom surface of the base plate. This is done to avoid an unnecessary limited construction being placed upon the claim."

A clear intention was therefore expressed in the amended application to avoid the restricted and technical construction which defendant now places on the words "substantially flush". The evidence indicates that the fact that the

original insert may extend about one one-hundredths of an inch below the work engaging surface of the saw does not interfere with or change the functioning of the saw in any material way. The finding here is that defendant's original insert does in fact extend substantially flush with the work engaging surface of the base plate of defendant's saw.

The origin of the term "free floating" which appears or is incorporated by reference in all three claims of the patent in suit was previously discussed in this opinion. It should be noted that in the specifications of McCarty '725, the patent issued for the revised insert, reference was made to the prior art including both the patent in suit and McCarty '089 covering the original insert, as "prior art anti-splintering inserts of the 'free floating' type". In fact, an object of McCarty '725 was stated to be to alleviate the difficulties associated with inserts of the free floating type by providing a resiliently retained insert. In other words, at the time that the application was filed for a patent for the revised insert McCarty himself agreed that the original insert was of the free floating type. Little credence can under such circumstances be given to defendant's present contention that its original insert as positioned in its U-40 saw was not free floating.

In any event, the evidence clearly shows that when the original insert is fitted in defendant's saw there is limited free floating lateral movement of the insert. For the reasons stated, it is the opinion of this Court that defendant's model U-40 saw fitted with the original insert infringes the patent in suit.

(b) *The Revised Insert*

As shown by the testimony, when its U-40 saw with the original insert was charged with infringement, defendant immediately went to work to avoid the charge by means of

a new device. Initially, McCarty proposed a substantial modification of the original insert to provide for resilient side arms. However, in order to save time and expense, it was decided to merely alter the existing mold of the original insert. McCarty's initial proposals for substantial changes in the original insert were abandoned and slight alterations in the mold of the original insert were made to come up with the revised insert. In other words, defendant deliberately chose not to depart substantially from the basic design of the original insert because to do so would take longer and would be more costly. That a minimum of experimental and testing work was involved in development of the current insert is indicated by the fact that some six weeks after receiving notice of infringment, the original insert had been revised and drawings had been prepared to show the necessary dimensions. Within eight weeks the revised insert had replaced the original insert in actual production. Whatever saving of time and expense resulted, such facts suggest that defendant did not do all that it might have done to develop a device which would avoid infringement of the patent in suit.

As to the revised insert, the pretrial order states that the defendant has admitted that all of the elements and features of claims 1, 2 and 3 of the patent in suit are present in its accused saw when fitted with such insert with the exception of the words "substantially flush" in claims 1 and 2 describing the relationship of the work engaging surface of the base plate and the insert, and the words "free floating" and "lateral" in all three claims, describing the movement of the insert relative to the base plate. As to claim 3, an additional exception is noted as to the words "whereby the blades serves" describing the means of maintaining the insert in the rear portion of the opening in the base plate and the tongue and groove formation in interlocking relation. The same stipulation has

been made as to the bottom surface of the revised insert being between .010 inch and .015 inch below the work engaging surface of the base plate of defendant's saw.

As to the "substantially flush" exception in the pre-trial order, what has previously been said with reference to the original insert likewise applies to the revised insert. For the same reasons, it is concluded that the revised insert, when fitted in defendant's saws, has a surface extending substantially flush with the work engaging surface of the base plate.

It is provided in the specifications that one of the objects of McCarty '725 covering the revised insert was to provide a "resiliently retain insert that has a limited pivoting movement in the plane of the insert." Defendant contends that the device in fact attains this objective and, therefore does not, when fitted in its saws, have free floating lateral movement.

In terms of the function of the device, the evidence shows that during the operation of the saw the revised insert freely floats or moves laterally in response to the action of the saw blade. What is described in the patent as the resilient holding feature is remote from the saw blade. As a result, in the vicinity of the blade itself there is freedom of movement or float so that the insert moves readily from side to side to conform with the blade. Such looseness attains the objectives of the patent in suit in permitting variations and inaccuracies in the machining of parts and in providing for proper cutting operations, while still performing an anti-splintering function. Whether the movement of the revised insert can be properly described as pivotal or otherwise is not material in terms of the function of the device. Defendant's roughly rectangular insert with ears may be quite different in appearance from Porter-Cable's circular insert. However, when placed in

a saw, the revised insert moves or floats in the same manner as does the circular insert. This Court is of the opinion that the revised insert is fitted in defendant's saws in such a manner as to constitute an attaching means providing limited free floating lateral movement.

Nor is there merit to defendant's final contention that its device does not infringe because the revised insert remains in place when the saw blade is removed. Both Porter-Cable's and defendant's inserts were designed for use *during* sawing operations. When the saw blades are in place and ready for operation neither the revised insert nor Porter-Cable's insert can be removed. It is therefore clear that the saw blade of defendant's saw, like that of Porter-Cable's, serves to maintain the insert in place in the opening in the base plate. The fact that the ears of the revised insert serve a similar purpose when the saw blade is removed is not material to the issue of infringement.

As the court said in *Chesapeake and Ohio Ry. Co.* v. *Kaltenbach,* 95 F. 2d 801, 804 (4th Cir., 1938), if the infringing device "perform the same function as the patented device, it is immaterial that it also performs some other function. It is still * * * an appropriation of the patented invention."

This Court concludes that defendant's U-251 and U-351 saber saws with the revised insert infringe claims 1, 2 and 3 of the patent in suit. As this Court said in *Ransburg Electro-Coating Corp.* v. *Procter Electric Co.,* 203 F. Supp. 235, 258 (D. Md. 1962):

> "The inventive ideas of plaintiff have been appropriated; supplementation and modification even if an improvement will not avoid infringement * * *."

Opinion of the United States District Court for the District of Maryland, Filed October 23, 1967

Damages

In the pretrial order, it was provided that all matters relating to damages would be reserved for later determination in the event that plaintiffs prevailed in this action. In addition to ordinary damages, plaintiffs seek treble damages and reasonable attorneys' fees under 35 U. S. C. A. §§ 284 and 285, on the grounds that defendant's infringement was deliberate and wilful. As the facts relating to these contentions were not fully developed at the trial, these issues will likewise be reserved for later determination.

Findings

This Court finds as facts and rules as a matter of law that:

1. Claims 1, 2 and 3 of Patent No. 2,842,170 are valid.

2. The defendant's U-40 saber saw with the original insert and the defendant's U-251 and U-351 saber saw with the revised insert each infringe claims 1, 2 and 3 of Patent No. 2,842,170.

This Court's findings of fact and conclusions of law under Rule 52(a) of the Federal Rules of Civil Procedure are embodied in the aforegoing opinion, whether or not expressly so characterized.

Counsel will prepare and submit within ten days an appropriate order.

/s/ Alexander Harvey II,
United States District Judge.

Interlocutory Judgment, Entered November 3,1967

THE PORTER-CABLE MACHINE COMPANY and
ROCKWELL MANUFACTURING COMPANY,
Plaintiffs,

v.

THE BLACK AND DECKER MANUFACTURING COMPANY,
Defendant.

Civ. A. No. 13791.
United States District Court
D. Maryland.

(Filed November 3, 1967)

This cause, having been considered by this court upon the pleadings and evidence presented on trial and upon briefs by counsel for the parties and upon the findings of fact and conclusions of law set forth in the opinion filed in this court on October 23, 1967, it is

ORDERED, ADJUDGED AND DECREED:

1. That Letters Patent of the United States No. 2,842,170 granted July 8, 1958 is valid as to claims 1, 2 and 3; and that plaintiff, Rockwell Manufacturing Company and its predecessor in title, The Porter-Cable Machine Company, have been the lawful owner of the entire right, title and interest in and to said Letters Patent and the invention thereof ever since its date of issue.

Interlocutory Judgment, Entered November 3, 1967

2. That defendant, The Black and Decker Manufacturing Company, has infringed said Letters Patent No. 2,842,-170 by making, selling and using the apparatus of claims 1, 2 and 3 thereof.

3. That the said defendant, The Black and Decker Manufacturing Company, its agents, attorneys, employees, associates and privies are enjoined and restrained from directly or indirectly infringing any of claims 1, 2, or 3 of Letters Patent No. 2,842,170 during its term and from offering or advertising so to do and from inducing or in any way contributing to the infringement of any of said claims.

4. That the plaintiff recover from the defendant for defendant's infringement of claims 1, 2 and 3 of said Letters Patent No. 2,842,170 damages according to law and this case is hereby referred to a master of this court to take and state an account of the plaintiffs' said damages and to assess the same; the defendant to pay all costs of this reference including the master's fee to be taxed or settled on final judgment of this court.

5. That the question of an award of interest and reasonable attorneys' fees and an increase of damages pursuant to 35 U. S. C. 284 is reserved for determination by the cou after settlement of the final judgment.

6. That the plaintiff recover from the defendant its cost and disbursements in this suit to be taxed by the Clerk.

FURTHER ORDERED ADJUDGED and DECREED that:

Execution of or any proceedings to enforce this judgment, including the appointment of a master pursuant to paragraph 4 hereof, be and the same hereby is stayed, and the injunction ordered pursuant to paragraph 3 hereof be and the same hereby is suspended, for a period of ten (10) days from the entry hereof; and that if within said ten

(10) day period defendant files notice of appeal from this judgment together with bond in the amount of Two Hundred Fifty Dollars ($250.00), the aforesaid stay and suspension be and the same hereby are continued pending said appeal.

/S/ ALEXANDER HARVEY, II,
United States District Judge.

Dated: November 3, 1967.

Approved as to form:

/S/ BENJAMIN C. HOWARD,
Attorney for Defendant.

/S/ NORMAN P. RAMSEY,
Attorney for Plaintiffs.

Opinion from the Fifth Circuit
(Swofford et al. v. B & W, Inc.)

COURT OF APPEALS

FIFTH CIRCUIT

Swofford et al. v. B & W, Inc.

No. 23861 Decided May 22, 1968

BEFORE WISDOM and GOLDBERG, Circuit Judges, and SEALS, District Judge.

WISDOM, Circuit Judge.

The Plaintiffs (for convenience collectively referred to here as Swofford) brought this patent infringement action in March 1961 against B & W, Inc.[1] The district court denied B & W's motion to strike Swofford's jury demand. On an interlocutory appeal we affirmed the action of the district court and held that Swofford was entitled to a jury trial on the issues of validity and infringement. *Swofford* v. *B & W, Inc.*, 5 Cir. 1964, 336 F. 2d 406, 142 USPQ 291, cert. denied, 379 U. S. 962, 85 S. Ct. 653, 13 L. Ed. 2d 557, 144 USPQ 780.

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[1] The plaintiffs in this action are Marvin K. Swofford and Marion F. Wright, inventors of the patented device, and Essex Corporation d/b/a The Pathfinder Company, the latter being substituted for the original exclusive licensee, Pathfinder Oil Tool Company. Swofford and Wright developed a new cleaning tool to be used in the oil industry for scraping the walls of a well bore. Until 1954 all such tools were called "scratchers" because of their protruding metal fingers or bristles. June 4, 1954, Swofford filed for a patent teaching a "wiper"—a new cleaning tool with cable loops (both ends fixed) instead of bristles, which supposedly eliminated certain problems caused by the "scratcher". Letters Patent issued in 1958, but B & W, Inc., developed and sold a similar "wiper" without Swofford's permission. This infringement action followed.

On remand, at the close of the evidence the questions of novelty, utility, and nonobviousness were framed in several interrogatories which, with the appropriate instructions by the court, were propounded to the jury. The jury found that the patent in issue was for a novel, useful, and non-obvious[2] invention. These findings, however, were not "the end of the matter."[3]

The district judge disregarded the express jury findings concerning nonobviousness under the following rationale:

> The ultimate issue of whether a patent meets the requisite standard of invention is a question of law rather than one of fact * * *. However, while invention is a question of law, what the prior art was and what the patentee did to improve upon it are questions of fact * * *. 251 F. Supp. at 815, 149 USPQ at 35.
>
> The critical question now to be decided as a matter of law by this Court is whether what Swofford and Wright have done to improve upon the prior art as it existed on June 4, 1954 rises to the standard of invention as defined by statute and in the courts. The answers of the jury to Interrogatories No's. 1, 3 and

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[2] The jury answered, for example, "We do" corresponding to each claim of the patent in answer to the interrogatory (No. 21): "Do you find that the combination defined in the claims of the plaintiffs' patent in suit is a combination the structure of which was not obvious as of June 4, 1954, to a man of ordinary skill in the art who had knowledge of all of the prior devices and references?" 251 F. Supp. at 815, 149 USPQ at 35.

[3] "[U]pon adjudication in court, under the statute, when novelty, utility and unobviousness as defined in section 103 are found to exist, and provided there is no one-year statutory bar, then there is patentability and that is the end of the matter." Rich, The Vague Concept of Invention as Replaced by Sec. 103 of the 1952 Patent Act, 46 J. Pat. Off. Soc'y 855, 866 (1964).

> 21 will have no influence upon this determination as they are in response to the ultimate question of validity itself, which I have found to be one of law rather than of fact. 251 F. Supp. at 817, 149 USPQ at 37.

The court went on to find the patent in issue invalid though infringed. 251 F. Supp. 811, 149 USPQ 32. Swofford appeals from the judgment of the district court, urging that obviousness is a question of fact for the jury rather than a question of law for the court; that the court, therefore, erred in substituting for the jury fact-finding of nonobviousness its own legal conclusion of obvious. B & W appeals from that portion of the court's decision holding that the patent was infringed. We affirm.

[1] We agree with the district court that obviousness is a question of law, and we approve the court's conclusion that Swofford's patent was obvious to a man of ordinary skill in the art who had knowledge of all the prior devices and references. Because of our holding that the patent was invalid, we do not reach the issue of infringement.

I.

The 1952 Patent Act sets out three conditions of patentability: novelty, utility, and nonobviousness. 35 U. S. C. § 101-03. Novelty and utility are defined in sections 101 and 102; these conditions track the 1874 codification of patent law and express the traditionally applied "new and useful" tests. Novelty[4] and utility,[5] clearly issues of fact, have

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[4] E.g., *Graver Tank & Mfg. Co.* v. *Linde Air Prod. Co.*, 1950, 339 U. S. 605, 609, 70 S. Ct. 854, 94 L. Ed. 1097, 85 USPQ 328, 330-331; *Bischoff* v. *Wethered*, 1869, 76 U. S. (9 Wall.) 812, 814, 19 L. Ed. 829.

[5] E.g., *Harley C. Loney Co.* v. *Ravenscroft*, 7 Cir. 1947, 162 F. 2d 703, 704, 74 USPQ 47, 48-49; *Gordon Form Lathe Co.* v. *Ford Motor Co.*, 6 Cir. 1943, 133 F. 2d 487, 496, 56 USPQ 495, 503.

existed in the statutory scheme of patentability since the Patent Act of 1793. The term "nonobviousness", however, appeared for the first time in section 103 of the 1952 act. It expresses the third condition for patentability as follows:

> § 103. Conditions for patentability; non-obvious subject matter
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

In 1966, in its first patent decision in many years the Supreme Court extensively analyzed the background and nature of section 103. *Graham* v. *John Deere Co.*, 383 U. S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545, 148 USPQ 459.[6] The Court concluded that while Congress focused upon "non-obviousness" rather than "invention" as characterizing the proper standard, both terms "place emphasis on the pertinent art existing at the time the invention was made and both are implicitly tied to advances in the art."[7] 383 U. S. at 14, 148 USPQ at 465. The court then observed:

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[6] See generally *Kitch, Graham* v. *John Deere Co.;* New Standards for Patents, 49 J. Pat. Off. Soc'y 237 (1967); Pugsley & Calvert, The Patentability of Inventions, 4 Hous. L. Rev. 467 (1963); Note 44 Texas L. Rev. 1405 (1966).

[7] "The Major distinction is that Congress has emphasized 'non-obviousness' as the operative test of the section, rather than the less definite 'invention' language * * *." 383 U. S. at 14, 148 USPQ at 465. In prior cases, however, the terms were often used interchangeably. E.g., *Monroe Auto Equip. Co.* v. *Heckethorn Mfg. & Supply Co.*, 6 Cir. 1964, 332 F. 2d 406, 410, 141 USPQ 549, 553 ("it may be said that invention is synonymous with unobviousness").

> While the ultimate question of patent validity is one of law, * * * the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, *the obviousness or nonobviousness of the subject matter is determined.* 383 U. S. at 17, 148 USPQ at 466-467.

The question here presented for our resolution is: *By whom* is the obviousness or nonobviousness of the subject matter to be determined?

A. The issue of nonobviousness or invention has, at various times, been held to present a legal,[8] factual,[9] or mixed[10] question. The Supreme Court at first took the position that the issue was one of fact. In *Keyes* v. *Grant,* 1886, 118 U. S. 25, 37, 6 S. Ct. 974, 30 L. Ed. 54, the Court stated:

> It was insisted by the patentees that no such arrangement and combination were to be found [in the prior art], and that the improvement which they constituted was not the result of mere mechanical skill, but sprung from a genuine effort of invention; and this view was supported by the opinion of many experts skilled in the art. In our opinion, this was

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[8] E.g., *Cee-Bee Chem. Co.* v. *Delco Chems., Inc.,* 9 Cir. 1958, 263 F. 2d 150, 153, 120 USPQ 72, 74.

[9] E.g., *Trico Prods. Corp.* v. *Delman Corp.,* 8 Cir. 1950, 180 F. 2d 529, 530, 84 USPQ 416, 417-418.

[10] E.g., *Hycon Mfg. Co.* v. *H. Koch & Sons,* 9 Cir. 1955, 219 F. 2d 353, 355, 104 USPQ 231, 232-233.

> **a question of fact, properly to be left for determination to the jury, under suitable instructions from the court upon rules of law which should guide them to their verdict.**

With one exception,[11] this view was followed until 1950.[12] In that year the Court decided *Great Atl. & Pac. Tea Co.* v. *Supermarket Equip. Corp.*, 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162, 87 USPQ 303. Although the relevant holding in that case is less than crystal clear,[13] the Court has since cited the A&P case as direct authority for the proposition that "the ultimate question of patent validity is one of law." *Graham* v. *John Deere Co.*, 1966, 383 U. S. 1, 17, 86 S. Ct. 684, 15 L. Ed. 545, 556, 148 USPQ 459, 466-467. This proposition has since stood unchallenged.

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[11] *Mahn* v. *Harwood*, 1884, 112 U. S. 354, 5 S. Ct. 174, 28 L. Ed. 665; see Note, A Valid Patent—*Graver* v. *Linde*, 5 N. Y. U. Intra. L. Rev. 70 (1950).

[12] *Graver Tank Mfg. Co.* v. *Linde Air Prods. Co.*, 1949, 336 U. S. 271, 69 S. Ct. 535, 93 L. Ed. 672, 80 USPQ 451; *Dow Chem. Co.* v. *Halliburton Oil Well Cementing Co.*, 1945, 324 U. S. 320, 65 S. Ct. 647, 88 L. Ed. 973, 64 USPQ 412; *Williams Mfg. Co.* v. *United Shoe Mach. Corp.*, 1942, 316 U. S. 364, 62 S. Ct. 1179, 86 L. Ed. 1537, 53 USPQ 478; *United Gas Public Service Co.* v. *Texas*, 1938, 303 U. S. 123, 58 S. Ct. 483, 82 L. Ed. 702; *United States* v. *Esnault-Pelterie*, 1936, 299 U. S. 201, 57 S. Ct. 159, 81 L. Ed. 123, 31 USPQ 298; *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 1924, 265 U. S. 445, 44 S. Ct. 533, 67 L. Ed. 1098; *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 1908, 210 U. S. 405, 28 S. Ct. 748, 52 L. Ed. 1122. The Supreme Court cases are discussed in Note, Appellate Review of Finding of Invention, 20 Geo. Wash. L. Rev. 605 (1952).

[13] See Comment, Appellate Review of Determinations of Patentable Inventions, 29 U. Chi. L. Rev. 185, 187 (1961); Note, Appellate Review of Finding of Invention, 20 Geo. Wash. L. Rev. 605, 621 (1952).

B. Swofford argues that this statement in *Graham* is not inconsistent with the proposition that obviousness is a fact question.[14] One court has properly observed, however, that "it becomes apparent that *the confusion* arising from the attempt to phrase the proper standard governing the determination of patentable invention *stems from the indiscriminate use of mere labels* which in themselves are not conclusive." *Armour & Co.* v. *Wilson & Co.*, 7 Cir. 1960, 274 F.2d 143, 155, 124 USPQ 115, 124-125. Deller suggests approaching this confusion by "breaking the question of patentable invention down into its component parts: what the prior art was and what the patentee did to improve upon it, and then, whether what the patentee did is properly to be classified as an invention." Deller's Walker on Patents § 105, at 67 (2d ed. 1964). The Seventh Circuit, sitting en banc to consider the precise question presented to this Court in the instant case, regarded the "component parts" of what constitutes invention (or nonobviousness) as follows:

> The first part relates to the showing made by the prior art before the patentee produces his invention. This is to be determined upon the basis of testimony and documentary or physical exhibits. The testimony relates to the use made of the prior art, and the documentary and physical exhibits do not stand

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[14] The plaintiff's position is that invention (nonobviousness), novelty, and utility are fact questions, but the over-all conclusion to be drawn from these is one of law. As phrased by one commentator: "In other words, it is a question of fact whether the device is an advance beyond mechanical skill over the prior art, whether it is original, and whether it possesses utility, but it is a conclusion of law to be drawn by the court whether all these add up to a patentable invention." As the author then answers: "It is submitted that this is not entirely logical." Note, Patentable Invention as a Question of Law, 43 Ill. L. Rev. 535, 536 (1948).

> mute but speak for themselves. Upon review, these are facts subject to Rule 52(a) and the exception found in the "Documentary Rule."
>
> The next element is concerned with the nature of the improvement the patentee has made over the prior art. Has he taught anything that is different? If there is no improvement, the patent is anticipated under Section 102 of the Patent Act. If there is an improvement, we look to Section 103 to see whether there is a difference or to ascertain the nature of the improvement over the prior art. The determination of this element of "novelty" usually finds its genesis in expert testimony and as such is a question of fact, and on appeal, is within the scope of Rule 52(a).
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> • • •
>
> The final step involves the resolution of the meaning of Section 103 of the Patent Act to determine, from the language of the statute, whether "the differences between the subject sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." This requires the application of the correct legal criteria to the factual determination made by the trial court. This calls for the exercise of a legal judgment and as such is subject to review by an appellate tribunal as a question of law.

C. Swofford tells us, however, that the Fifth Circuit's decisions hold that invention is a question of fact for the jury. While there is *some* truth in this statement, for the most part it represents precisely the type of confusion that arises from "the indiscriminate use of mere labels". Indeed, there are decisions of this Court stating squarely:

"The question of invention was here, as it ordinarily is, one of fact * * *." *E.g., Hahn & Clay* v. *A. O. Smith Corp.*, 5 Cir. 1963, 320 F. 2d 166, 173, 138 USPQ 369, 374. See also *Reynolds-Southwestern Corp.* v. *Dresser Indus., Inc.*, 5 Cir. 1967, 372 F. 2d 592, 595, 152 USPQ 530, 532-533. Others merely affirm district court "findings of fact" that certain patents rise to the level of "invention" or are "nonobvious", sometimes upholding these findings as not clearly erroneous. *E.g., Zero Mfg. Co.* v. *Mississippi Milk Prod. Ass'n*, 5 Cir. 1966, 358 F. 2d 853, 857, 149 USPQ 70, 73-74; *Lorenz* v. *General Steel Prods. Co.*, 5 Cir. 1964, 337 F. 2d 726, 728, 143 USPQ 140, 141-142; *Italit, Inc.* v. *Johns-Manville Corp.*, 5 Cir. 1964, 331 F. 2d 663, 666, 141 USPQ 319, 320-321. Still others vacillate between the poles: "Validity, while often a pure legal question, is frequently one of fact for resolution by the trier, including a jury." *Hughes Tool Co.* v. *Varel Mfg. Co.*, 5 Cir. 1964, 336 F. 2d 61, 62 n.1, 142 USPQ 407.

On the other side, however, stand decisions proposing that "the question whether a particular patent meets the standard of invention is a fully reviewable question of law." *Houston Oil Field Material Co.* v. *Claypool*, 5 Cir. 1959, 269 F. 2d 134, 137, 122 USPQ 443, 444-445; *Fritz W. Glitsch & Sons* v. *Wyatt Metal & Boiler Works*, 5 Cir. 1955, 224 F. 2d 331, 335, 106 USPQ 162, 164-165; *Little Mule Corp.* v. *The Lug All Co.*, 5 Cir. 1958, 254 F. 2d 268, 275-76, 117 USPQ 111, 115-117. See also *Butex Gas Co.* v. *Southern Steel Co.*, 5 Cir. 1941, 123 F. 2d 954, 955, 51 USPQ 490, 491. Our most recent decisions point to resolution of the apparent inconsistency similar to the Seventh Circuit's: "The question of patent validity is one of law, but to be decided on the results of factual inquiries." *National Filters, Inc.* v. *Research Prod. Corp.*, 5 Cir. 1967, 384 F. 2d 516, 155 USPQ 355; *Sisko* v. *Southern Resin & Fiberglass Corp.*, 5 Cir. 1967, 373 F. 2d 866, 868, 153 USPQ 7, 8-9;

Up-Right, Inc. v. *Safway Prods. Inc.*, 5 Cir. 1966, 364 F. 2d 580, 582, 150 USPQ 579, 580. See also *Hensley Equip. Co.* v. *Esco Corp.*, 5 Cir. 1967, 383 F. 2d 252, 155 USPQ 183; *Metal Arts Co.* v. *Fuller Co.*, 5 Cir. 1968, 389 F. 2d 318, 156 USPQ 605.

The Courts of Appeals in the Sixth and Ninth Circuits have extensively reviewed their opinions in those circuits and have concluded that nonobviousness is a question of law. *Monroe Auto Equip. Co.* v. *Heckethorn Mfg. & Supply Co.*, 6 Cir. 1964, 332 F. 2d 406, 141 USPQ 549; *Bergman* v. *Aluminum Lock Shingle Corp.*, 9 Cir. 1958, 251 F. 2d 801, 809, 116 USPQ 32, 38 (concurring opinion). Those decisions and that of the Seventh Circuit took different routes in synthesizing earlier decisions,[15] but all reached the same conclusion. We adopt the position taken in these circuits.[16].

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[15] *Monroe Auto Equip. Co.* v. *Heckethorn Mfg. & Supply Co.*, 6 Cir. 1964, 332 F. 2d 406, 411, 141 USPQ 549, 553-554: "To the extent that the first two steps in the determination of invention involve questions of fact, we think these prior cases [in which it was said that invention is a question of fact] are not inconsistent with what we presently hold to be the correct rule."

Armour & Co. v. *Wilson & Co.*, 7 Cir. 1960, 274 F. 2d 143, 157, 124 USPQ 115, 125-126: "If anything we have said in prior opinions strays too far from this conclusion, such holdings are now modified to conform to the views expressed herein."

Bergman v. *Aluminum Lock Shingle Corp.*, 9 Cir. 1958, 251 F. 2d 801, 812, 116 USPQ 32, 40-41 (concurring opinion): "It is my view that a study of this court's decisions since the Great A. & P. Tea Co. case, supra, which have stated that the question of invention is one of fact, will demonstrate either that such statement in that unqualified form was unnecessary to the decision, or else that the court was saying in substance that under the particular facts of the case the decision 'turned upon' questions of fact."

[16] See the discussion in Comment, Appellate Review of Determinations of Patentable Inventions, 29 Chi. L. Rev. 185, 192-198 (1961).

> "'Thus what we have in a patent case are three steps: First, a determination of what the prior art was; this involves factual questions, Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact, The final step is to determine whether the improvement would have been obvious to one skilled in the art. This requires application of a legal criteria [sic] and therefore, is a question of law, fully reviewable by the appellate court." *Monroe Auto Equip Co.* v. *Heckethorn Mfg. & Supply Co.*, 6 Cir. 1964, 332 F. 2d 406, 411, 141 USPQ 549, 553-554.

This position has been taken, without extensive discussion, in at least four other circuits[17] (i.e. other than Sixth, Seventh, and Ninth). Commentators advocated it.[18] We find no recent decision holding otherwise.

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[17] Second Circuit: E.g., *Hygienic Specialties Co.* v. *H. G. Salzman, Inc.*, 2 Cir. 1962, 302 F. 2d 614, 617 n.6, 133 USPQ 96, 99; *Tatko Bros. Slate Co.* v. *Hannon*, 2 Cir. 1959, 270 F. 2d 571, 572, 122 USPQ 585, 586. Third Circuit: E.g., *Packwood* v. *Briggs & Stratton Corp.*, 3 Cir. 1952, 195 F. 2d 971, 973-74, 93 USPQ 274, 275-276. Fourth Circuit: E.g., *Heyl & Patterson, Inc.* v. *McDowell Co.*, 4 Cir. 1963, 317 F. 2d 719, 722, 137 USPQ 620, 622-623. Tenth Circuit: *Griswold* v. *Oil Capital Valve Co.*, 10 Cir. 1966, 375 F. 2d 532, 538, 152 USPQ 95, 99-100; *Blish, Mize & Silliman Hardware Co.* v. *Time Saver Tools, Inc.*, 10 Cir. 1956, 236 F. 2d 913, 916, 111 USPQ 6, 9. Accord: *In re Sporck*, Ct. Cust. & Pat. App. 1962, 310 F. 2d 686, 133 USPQ 360; *In re Eller*, Ct. Cust. & Pat. App. 1962, 299 F. 2d 272, 132 USPQ 467. Contra. D. C. Circuit: *Schafer* v. *Watson*, D. C. Cir. 1961, 288 F. 2d 144, 145, 128 USPQ 283; *C. H. Boehringer Sohn* v. *Watson*, D. C. Cir. 1958, 256 F. 2d 713, 117 USPQ 223.

[18] E.g., Deller's Walker on Patents § 105, at 67 (2d ed. 1964); Comment, Appellate Review of Determinations of Patentable Inventions, 29 U. Chi. L. Rev. 185, 197-99 (1961).

II.

Our conclusion that the ultimate issue under section 103 is one of law carries our approval of the district court's having withdrawn the issue from the jury and having independently decided it. We need not repeat here the facts as found in the court below; nor do we feel it necessary to summarize the court's application of the legal standard of nonobviousness to those facts. The district judge withheld his Memorandum and Order until after Graham was decided and reviewed his holding in its light. We find that his opinion correctly applies the law set out in Graham. We therefore adopt the relevant portion of the district court's opinion. *Swofford* v. *B. & W. Inc.*, S. D. Tex. 1966, 251 F. Supp. 811, 815-19, 149 USPQ 32, 35-39.

Since we dispose of this appeal on the validity issue, it is unnecessary for us to consider the question of infringement or to pass upon B & W's defense that Swofford misused the patent.

The judgment of the district court that the plaintiff's patent is invalid is therefore affirmed.

SUPREME COURT, U. S.

FILED
JAN 3 1969
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 802

THE BLACK AND DECKER MANUFACTURING COMPANY,
Petitioner,

v.

THE PORTER-CABLE MACHINE COMPANY AND ROCKWELL MANUFACTURING COMPANY, *Respondents.*

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT OF THE CASE

Petitioner's statement of the case must be rejected since it is, in the main, argumentative rather than factual as required by Rule 23(e) of the rules of this Honorable Court.

Respondents, manufacturers of power tools, brought this patent suit against Petitioner, a principal competitor, to prevent continuing unlicensed manufacture by Petitioner of a portable saber saw developed at great expense by Respondents, patented by Respondents and sold in substantial quantities by Respondents.

The vigor with which the case was contested is evidenced by the record which comprises almost eleven hundred pages of trial transcript and over a hundred exhibits, many of which are relatively complex mechanical devices explained in detail to the District Court by experts for both parties. The length and quality of the District Court's opinion led the Court of Appeals to remark (159 USPQ 66; — F.2d —):

> "Resolution of the issues in the case required and received painstaking study. Without a jury, the trial occupied six days; both experts and pragmatists gave evidence to the critical points of the claims."

In the briefs submitted to the District Court before and after the trial, as well as in the briefs submitted to the Fourth Circuit Court of Appeals, the parties, in a rare display of accord, advised the courts that the issue of validity of Respondents' patent was to be determined in accordance with this Honorable Court's decision in *Graham* v. *John Deere*, 383 U.S. 1. The District Court and the majority of the Fourth Circuit Court of Appeals quoted and strictly followed *Graham* on the issue of patentability.

Only the dissenting opinion in the Court of Appeals failed to refer to *Graham* or for that matter to any

decision or to any statute on the issue of the validity of Respondents' patent.

This petition is essentially a carbon copy of Petitioner's request for rehearing En Banc addressed to the Fourth Circuit Court of Appeals which the court quickly denied without opinion.

ARGUMENT

The petition fails utterly to present any "special and important reason" for granting the writ and thus fails to meet the basic requirements of Rule 19 of this Honorable Court.

Question I

Petitioner's "QUESTION I" purports to raise an issue of importance. But this is illusory. Petitioner asks:

> "Can a patent lawfully be adjudged valid by a U. S. Court of Appeals on the *sole basis* of *fact findings* * * * ?"

The question attributes to the Court of Appeals an appellate technique which the court simply did not employ. While the Court of Appeals paid due respect to the District Court's findings of fact, noting particularly the judicial scrutiny and deliberation from which the District Court's findings evolved, the Court of Appeals nevertheless expressly reserved for its own decision the ultimate question of law. The Court of Appeals stated (159 USPQ 66; — F.2d —):

> "From these foundation facts, patentability of the device in suit soundly follows as a conclusion of law and the declaration of infringement must also be upheld."

The Court of Appeals also noted with approval that (159 USPQ 66; — F.2d —):

> "The (Trial Court's) pattern for decision prescribed in *Graham* v. *Deere,* supra, 383US1 was pursued almost ad verbum. The primary inquiries there directed were exhausted by the District Judge who arrayed and measured the evidence on each."

Questions II & III

Petitioner's Questions II & III are nothing more than the expression of an unsuccessful litigant's dissatisfaction with the result reached by the court below. Patently, they present no special or important reason for granting this writ.

The Asserted Conflict

Petitioner's position in asserting a conflict between the circuits, is predicated on the differences in the manner in which the Courts of Appeals articulate their views. Petitioner, however, overlooks the substantive agreement of the Courts of Appeals, consonant with this court's decision in *Graham,* supra, that the ultimate issue, whether it be labeled validity, patentability or something else, is a question of law fully reviewable by the Courts of Appeals. The Courts of Appeals are also in agreement, again in complete harmony with this court's decision in *Graham,* that the conditions for patentability lend themselves to basic factual inquiries, the painstaking resolution of which by the District Court is to be respected by the Courts of Appeals, absent clear error.

CONCLUSION

For the foregoing reasons we respectfully suggest that this case presents no issue of special importance, the resolution of which requires drawing on the resources and time of this Honorable Court. We accordingly respectfully suggest that the petition be denied.

Respectfully submitted,

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Certificate of Service

Service of this Respondents' Brief in Opposition to Petition for Writ of Certiorari has been made on petitioner by mailing, postage prepaid, to Theodore S. Kenyon, 59 Maiden Lane, New York, N. Y. 10038, Benjamin C. Howard, Miles & Stockbridge, 10 Light Street, Baltimore, Maryland 21202, C. Willard Hayes, Cushman, Darby & Cushman, American Security Bldg., Washington, D. C. 20005, on January 3, 1969.

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